

No. _____

05-648 NOV 9 2005

In The
Supreme Court of the United States

OFFICE OF THE CLERK

FREEDMAN SEATING COMPANY,

Petitioner,

vs.

AMERICAN SEATING COMPANY,

Respondent.

**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The doctrine of equivalents prevents a copyist from avoiding patent infringement by making unimportant and insubstantial changes to a patented invention. This Court unanimously affirmed this well-established doctrine in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), and reaffirmed its vitality in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722 (2002). In conducting an inquiry under the doctrine of equivalents, the determination of equivalence should be applied as an objective inquiry on an element-by-element basis, taking into account “whether a substitute element matches the function, way and result of the claimed element.” *Warner-Jenkinson*, 520 U.S. at 40.

The United States Court of Appeals for the Federal Circuit has held on numerous occasions, including the case at bar, that where an element of an accused device was known to an inventor to be “foreseeably” interchangeable with an element of a patent claim, this factor weighs **against** a finding of equivalence as to that element. However, this Court has previously held, as affirmed most recently in *Warner-Jenkinson*, that the “known interchangeability” of an element of an accused device and an element of a patent claim, is a factor that expressly weighs **in favor of** a finding of equivalence – not against it.

QUESTIONS PRESENTED - Continued

The questions presented, therefore, are:

1) Whether a court can find non-equivalence between an element of an accused device and an element of a patent claim, as a matter of law, so as to deprive the patentee of its right to a jury trial, where there is no factual dispute that the claimed and accused elements are interchangeable; and

2) Whether a court can find non-equivalence between an element of an accused device and an element of a patent claim, as a matter of law, where there is no factual dispute that the accused element performs the same function in the same way to achieve the same result as the claimed element.

PARTIES TO THE PROCEEDING

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Petition for Writ of Certiorari.

RULE 29.6 STATEMENT

Petitioner Freedman Seating Company has no parent corporation and no publicly held company owns 10% or more of Petitioner's stock.

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OPINIONS BELOW

The opinion of the U.S. Court of Appeals for the Federal Circuit is reported at 420 F.3d 1350, and is reprinted in the Appendix to the Petition ("App.") at App. 1-29. The district court's order granting summary judgment to Freedman on the issues of infringement and validity, which is not reported, is reprinted at App. 30-55. The district court's order granting in part and denying in part Respondents' motion for reconsideration, which is not reported, is reprinted at App. 56-63. The district court's order granting summary judgment to Freedman on the issue of inequitable conduct, which is not reported, is reprinted at App. 64-71.

JURISDICTION

The Court of Appeals entered its judgment on August 11, 2005. This Court has jurisdiction under 28 U.S.C. §1254(1).

STATUTE INVOLVED

35 U.S.C. §271(a) provides:

"Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent."

STATEMENT OF THE CASE

This case presents two questions which involve the "whittling away" of the "doctrine of equivalents" by the Court of Appeals for the Federal Circuit, in a manner which adversely affects the expectations of patent owners based upon this Court's precedent. Under this well-established doctrine, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). This doctrine has been consistently applied by this Court, in numerous cases, since the doctrine was first embraced in 1853. See *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608-09 (1950) (listing cases). The application of the doctrine of equivalents is a frequently recurring issue in patent law and practice.

A. The '389 Patent

Petitioner Freedman Seating Company ("Freedman") owns U.S. Patent No. 5,492,389 ("the '389 patent") (App. 3). The '389 patent covers a stowable seat for transit vehicles (such as buses, trains, etc.) which is able to move between a horizontal (deployed) position and a vertical (stowed) position, to provide space for positioning a wheelchair within the vehicle (App. 3-5). The stowable seat of the invention comprises a seatback and a seatbase which are attached to a frame (App. II-5, '389 patent, col. 1, lines

40-45).¹ Moving the seat from its horizontal to its vertical position generally involves folding the seatback flat against the seatbase, unlocking the seatbase, and raising the seatbase to its vertical position where it is locked in place (App. 5; '389 patent, col. 1, lines 19-24).

The novelty of the invention lies in the fact that the stowable seat does not use an aisle leg to support the seat when in the horizontal position, but rather is based on a cantilever design, in which the free (or aisle) end of the seatbase is supported by a diagonal truss, or "support member" (App. 5; App. II-5, '389 patent, col. 1, lines 25-35; 52-58). The diagonal truss has a fixed end attached to the seat's frame at a pivot point, and a movable end attached to the free end of the seatbase (App. 5; App. II-5, '389 patent, col. 1, lines 48-52). Notably, the attachment point for the movable end of the diagonal truss **shifts** from a position under the middle of the seatbase when the seat is stowed, to a position under the aisle end of the seatbase when the seat is deployed, to provide passenger support for the aisle end of the seatbase. In so doing, the diagonal truss provides the seatbase with a range of motion extending from its horizontally deployed position to its vertically stowed position (App. 5; App. II-5, '389 patent, col. 1, lines 48-52).

In the preferred embodiment of the invention shown in the '389 patent, the movable end of the diagonal truss shifts by sliding on a runner track which is mounted to the

¹ In view of the fact that the Court of Appeals' discussion of the '389 patent and the accused devices is at times incomplete and/or factually inaccurate, Petitioner has submitted herewith a copy of the '389 patent itself, pursuant to Supreme Court Rule 32.3 (App. II-1-App. II-8), to enable this Court to fully appreciate the technical details of the invention.

underside of the seatbase, to enable the seatbase to be rotatably transitioned between its horizontal and vertical positions (App. 5; App. II-2; App. II-5, '389 patent, col. 1, lines 19-24).² Notably, the movable end of the diagonal truss is provided with both **translational** (i.e., side-to-side) **and rotational** motion relative to the seatbase, as the seatbase is raised from its horizontal to its vertical position (App. II-6, '389 patent, col. 3, lines 41-56). However, the Court of Appeals failed to address the fact that the '389 patent expressly teaches that the movable end of the diagonal truss moves both translationally **and** rotationally, relative to the seatbase (App. 5). It is undisputed that the mechanism formed by the seatbase, the diagonal truss and the frame forms what is known to one of skill in the art of mechanical engineering as a "slider crank," which is a particular type of a general class of mechanisms known in the art as "four bar mechanisms" (App. 5).³

B. The Accused EZ Fold Seat

Respondents American Seating Company and Hi-Tech Seating Products, Inc. (collectively "Respondents") compete with Freedman in the manufacture and sale of

² While the Court of Appeals refers to the movement of the seatbase as "translational movement of the seatbase between the horizontal and vertical positions" (App. 5), this is an inaccurate description. In actuality, the seatbase *cannot* move translationally, inasmuch as it is mounted to the frame at its fixed end. Rather, the seatbase *rotates* about its fixed end, between its horizontal (deployed) position and its vertical (stowed) position.

³ Again, the Court of Appeals' description here is inaccurate, as it refers to the "folding mechanism created by the slidably mounted movable end" as a "slider crank," when in actuality it is the entire seatbase-diagonal truss-frame assembly that forms the "slider crank" type of "four bar mechanism."

seating products for the transportation industry (App. 7). Respondents manufacture and sell a competing stowable seat under the name "Horizon EZ Fold" ("EZ Fold"), which the Federal Circuit expressly acknowledged is, in nearly all respects, identical to Freedman's patented seat (App. 7).

The sole difference between the EZ Fold and Freedman's patented seat is the fact that the EZ Fold seat includes an insubstantial change in the way the movable end of the diagonal truss is mounted to the seatbase. Rather than being mounted to the seatbase by way of a runner track, as is the case with Freedman's patented seat, the movable end of the EZ Fold support member is mounted to the seatbase by way of an additional truss, referred to by the Court of Appeals as a "fourth link" (App. 7). The movable end of the EZ Fold diagonal truss is attached to one end of the "fourth link," while the other end of the "fourth link" is fixed to the bottom of the seatbase at a single location (App. 7-8). Thus, the movable end of the EZ Fold, like the movable end of Freedman's patented seat, is provided with both **translational and rotational** motion relative to the seatbase, as the seatbase is raised or lowered between its horizontal and vertical positions.⁴ It is likewise undisputed that the

⁴ Again, the Court of Appeals' description of the motion of the EZ Fold's movable end is inaccurate. While the Court of Appeals states that "the only range of motion [of the EZ Fold movable end] consists of rotation throughout its revolute joints" (App. 7), that statement is simply incorrect. In actuality, the movable end of the EZ Fold diagonal support moves both translationally and rotationally with respect to the EZ Fold seatbase. This is best appreciated by reference to the diagrams in the record below showing the EZ Fold seat as it moves from its horizontal position to its vertical position, several of which are shown at App. 8, and the entirety of which (found at Fed. Cir. Appendix A2994-3013) are submitted herewith, pursuant to Supreme Court Rule 32.3,

(Continued on following page)

mechanism formed by the EZ Fold seatbase, diagonal truss, "fourth link" and frame, like Freedman's patented seat, forms a "four bar mechanism" (App. 7).

C. The District Court Decision

Freedman sued Respondents in the U.S. District Court for the Central District of California for patent infringement and unfair competition under the Lanham Act, 15 U.S.C. §1125 (App. 1). The district court granted summary judgment in favor of Freedman on both the issue of infringement under the doctrine of equivalents, and on the issue of invalidity by reason of obviousness (App. 1-2, 30-55). In finding that there was no genuine issue of material fact with regard to the issue of infringement, the district court determined that "the elements of [Freedman's claimed] slider-crank and [Respondents'] fourth link perform substantially the same function in substantially the same manner to achieve substantially the same result" (App. 51).

After Respondents filed a motion for reconsideration, the district court granted Respondents' motion in part (App. 56-63), after which it granted summary judgment in favor of Freedman on Respondents' affirmative defense of

for this Court's reference (App. II-10-II-19). It can be clearly seen from these diagrams that, when the EZ Fold is in its horizontal position (App. II-14), the movable end of the diagonal truss is located adjacent the free (or aisle) end of the seatbase. However, when the EZ Fold is in its vertical position, the movable end of the diagonal truss is located near the middle of the seatbase (App. II-17). Clearly, during the transition between the horizontal and vertical positions, the movable end of the diagonal truss moves translationally, as well as rotationally, to shift positions between those two locations (App. II-15-II-16).

unenforceability based upon alleged inequitable conduct (App. 2, 64-71). The district court then held a jury trial to determine damages (App. 2).

D. The Federal Circuit Opinion

Both Freedman and Respondents appealed aspects of the district court verdict to the Court of Appeals for the Federal Circuit (App. 2). The court reversed the district court's judgment of infringement, and remanded the case with instructions to enter judgment of non-infringement in favor of Respondents (App. 2-3).⁵ In so doing, the court did not dispute the district court's finding, argued by Freedman on appeal, that the movable end of the EZ Fold support member performed "substantially the same function in substantially the same manner to achieve substantially the same result" as the movable end of Freedman's support member (App. 24).

Notwithstanding that fact, the Federal Circuit held, relying on the reasoning of several of its earlier decisions, that the district court's finding that the movable end of the EZ Fold support member was equivalent to the movable end of Freedman's patented seat "had the effect of entirely vitiating the 'slidably mounted' limitation" of Freedman's patent claims (App. 21-24). In reaching that conclusion, the court noted with approval its prior decision in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997), in holding that, because the inventors of the '389 patent were "aware of other types of four

⁵ Although the Federal Circuit also reversed the district court's judgment on the issue of invalidity, that issue is not presently before this Court, and therefore merits no further discussion.

bar mechanisms," but had drafted their patent claims to include a "slidably mounted" movable end limitation, the claims of the '389 patent could not be extended to cover other types of "four bar mechanisms" (App. 25). As a result, the court held, as a matter of law, that the accused EZ Fold seat did not infringe any claim of the '389 patent under the doctrine of equivalents (App. 24-26) – despite the fact that the movable end of the support member in the accused EZ Fold seat conforms to the teaching of col. 3, lines 41-45 of the '389 patent (App. II-6), which teaches that a "slidably mounted" movable end is one that can move both translationally and rotationally relative to the seatbase.

REASONS FOR GRANTING THE PETITION

This Court should grant *certiorari* to decide whether a lower court may determine non-infringement under the doctrine of equivalents, as a matter of law, where there is no factual dispute that (a) the accused element and the patented element are known to be readily interchangeable, and (b) the accused element performs the same function in the same way to achieve the same result as the patented element. Both of those factors – which, under this Court's precedent, would **require** a finding of infringement as a matter of law, or at the very least a finding that application of the doctrine of equivalents presents a genuine issue of material fact for a jury – are present in the case before this Court. Yet, the Federal Circuit somehow arrived at a finding of non-infringement, as a matter of law. In so doing, the Federal Circuit simply turned a blind eye to this Court's clear precedent.

The Federal Circuit's holding in this case appears to continue its recent assault on the doctrine of equivalents. Indeed, this Court's decisions in *Warner-Jenkinson* and *Festo* were necessitated by the fact that the Federal Circuit had misapplied this Court's prior decisions as they related to the doctrine of equivalents. See *Warner-Jenkinson*, 520 U.S. at 21 (noting "significant disagreement within the Court of Appeals for the Federal Circuit concerning the application of *Graver Tank*"); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 739 (2002) (noting that "[t]he Court of Appeals ignored the guidance of *Warner-Jenkinson*, which instructed that courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community").

Despite these warnings, the Federal Circuit continues to chip away at the doctrine of equivalents, in disregard of this Court's decisions in *Graver Tank* and *Warner-Jenkinson*. In so doing, it continues to circumscribe the rights and expectations of patent owners and the public, aiding the cause of copyists everywhere. As this Court noted in *Graver Tank*:

[T]o permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for – indeed encourage – the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law . . . Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of

verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

339 U.S. at 607.

Because the Federal Circuit has exclusive jurisdiction of patent appeals from district courts, there can be no circuit conflict. Nor is it possible for the issues presented here to be addressed in other circuits. The conflict between the Federal Circuit's holding in this case and this Court's precedent, plus the irreparable damage to patent law and incentives for innovation threatened by the Federal Circuit's decision, make review by this Court now not only appropriate, but essential to protecting the rights of patent owners. *See Festo*, 535 U.S. at 739 (noting that the doctrine of equivalents is "settled law," and that "fundamental alterations in [this rule] risk destroying the legitimate expectations of inventors in their property").

A. The Federal Circuit's "Foreseeability" Limitation on the Doctrine of Equivalents Conflicts Directly With the Decisions of This Court

In *Graver Tank*, this Court held that an important factor in determining whether an element of an accused device is equivalent to an element of a patent claim is "whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was." *Graver Tank*, 339 U.S. at 609. In *Graver Tank*, this Court considered the application of the doctrine of equivalents to an accused chemical composition for use in welding that differed from

the patented welding material by the substitution of one chemical element. 339 U.S. at 610. The substituted element did not fall within the literal terms of the patent claim, but the Court nonetheless found that the "question which thus emerges is whether the substitution [of one element for the other] is a change of such substance as to make the doctrine of equivalents inapplicable." *Id.* The Court also described some of the considerations that go into applying the doctrine of equivalents:

What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. **An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.**

Id. at 609 (emphasis added).

In *Graver Tank*, the patent claim at issue was directed to a welding composition (or "flux") containing a combination of alkaline earth metal silicate and calcium fluoride. *Id.* at 610. The accused composition contained a silicate of

manganese - which is not an alkaline earth metal - instead of magnesium, which is an alkaline earth metal. *Id.* The question before the Court was whether the substitution of manganese for an alkaline earth metal such as magnesium was, "under the circumstances of [the] case, and in view of the technology and prior art, a change of such substance as to make the doctrine of equivalents inapplicable; or conversely, whether under the circumstances the change was so insubstantial that . . . invocation of the doctrine of equivalents was justified." *Id.*

In holding that the substitution of manganese for an alkaline earth metal was insubstantial, the Court noted significant evidence in the record that the two were **interchangeable**, including (1) testimony from chemists familiar with the fluxes that manganese and magnesium were similar in many of their reactions; (2) testimony by a metallurgist that alkaline earth metals are often found in manganese ores in their natural state and that they serve the same purpose in the fluxes; (3) corroboration of the testimony by reference to recognized texts on inorganic chemistry; and (4) disclosures of the prior art which taught the use of manganese in welding fluxes. *Id.* at 610-11. The Court then noted the factual finding of the trial court that manganese silicate could be effectively substituted for the claimed alkaline earth metal silicates. *Id.* at 611-12.

In view of the evidence before it, the Court held that the trial court's judgment of infringement under the doctrine of equivalents was proper, stating that:

It is difficult to conceive of a case more appropriate for application of the doctrine of equivalents. The disclosures of the prior art made clear that manganese silicate was a useful ingredient in

welding compositions. Specialists familiar with the problems of welding compositions understood that manganese was equivalent to and could be substituted for magnesium in the composition of the patented flux and their observations were confirmed by the literature of chemistry ... Though infringement was not literal, the changes which avoid literal infringement are colorable only.

Id. at 612.

In *Warner-Jenkinson*, this Court reaffirmed *Graver Tank*, holding that known interchangeability is an important factor in determining whether an accused element is equivalent to an element of a patent claim. 520 U.S. at 24-25. Indeed, this Court stated that "[t]he known interchangeability of substitutes for an element of a patent is one of the express objective factors noted by *Graver Tank* as bearing upon whether the accused device is substantially the same as the patented invention." *Id.* at 36. The Court went on to note that:

[A] skilled practitioner's knowledge of the interchangeability between claimed and accused elements is not relevant for its own sake, but rather for what it tells the fact-finder about the similarities or differences between those elements. Much as the perspective of the hypothetical 'reasonable person' gives content to concepts such as "negligent" behavior, the perspective of a skilled practitioner provides content to, and limits on, the concept of "equivalence."

Id. at 37.

Thus, it is clear from this Court's opinions in *Graver Tank* and *Warner-Jenkinson* that the known **inter-changeability** between claimed and accused elements to one of skill in the art remains an important factor weighing **in favor** of a finding of equivalence – not against it.

The Federal Circuit, however, in developing its doctrine of "foreseeability," has chosen to ignore or disregard this Court's clear precedent. This doctrine was first articulated in the Federal Circuit's *Sage Products* decision, where that court held that a patentee was not entitled to expand the scope of its claims through the doctrine of equivalents, because it failed to draft claims that were worded differently, so as to cover a "foreseeable alteration of its claimed structure." 126 F.3d at 1425. In that case, the court held that a patentee whose claims for a container required, *inter alia*, an "elongated slot at the top of the container body" and a "first constriction extending over said slot" was not entitled to a claim scope under the doctrine of equivalents that would cover a container in which the "first constriction" was located below the top of the container. *Id.* at 1422-25. In so doing, the court noted that, in order to extend the doctrine of equivalents to cover the accused container, it would have to "remove entirely the 'top of the container' and 'over said slot' limitations from the claim." *Id.* at 1424.

The Federal Circuit further explained its basis for holding that the doctrine of equivalents could not apply in that case, by introducing a questionable "foreseeability" limitation on the doctrine of equivalents. The court stated that "[a] skilled patent drafter would *foresee* the limiting potential of the 'over said slot' limitation . . . [T]he patentee must bear the cost of its failure to seek protection for

this *foreseeable* alteration of its claimed structure." *Id.* at 1425 (emphasis added).

The court acknowledged that its new "foreseeability" limitation placed significant limits on the doctrine of equivalents, noting that its new doctrine "may lead to higher costs of patent prosecution." *Id.* However, the court attempted to justify its holding by stating that, "[g]iven a choice of imposing the higher costs of careful prosecution on patentees, or imposing the costs of reclosed business activity on the public at large, this court believes the costs are properly imposed on the group best positioned to determine whether or not a particular invention warrants investment at a higher level, that is, the patentees." *Id.*

What the Federal Circuit failed to do in *Sage Products*, however, is to acknowledge that its new doctrine of "foreseeability" was in direct conflict with this Court's holdings in *Graver Tank* and *Warner-Jenkinson*, which held that where the substitution of a claimed element with an accused element was known (and thus "foreseeable") to persons skilled in the art to be "interchangeable," that knowledge (or "foreseeability") of such "interchangeability" is an important factor that weighs in favor of a finding that the claimed and accused elements are equivalent. Notwithstanding that fact, the Federal Circuit has continued to apply its "foreseeability" doctrine in subsequent cases to limit the applicability of the doctrine of equivalents, in contravention of this Court's prior holdings.⁶ *See*,

⁶ Notably, however, the *Sage Products* "foreseeability" doctrine has been criticized by Judge Lourie of the Federal Circuit in his concurrence in *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046 (Fed. Cir. 2002), as "creat[ing] conflicts with conventional patent law ideas," due to the fact that the "concept of foreseeability" (Continued on following page)

e.g., *Fin Control Systems Pty, Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1320-21 (Fed. Cir. 2001) (citing *Sage Products*); *Vehicular Technologies Corp. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1383-84 (Fed. Cir. 2000) (Rader, J. concurring) (citing *Sage Products*).

The error of the Federal Circuit's "foreseeability" doctrine is exemplified by the fact that, under this doctrine, a district court considering the facts of *Graver Tank* today would reach the very opposite result that this Court reached in that case. Indeed, the *Graver Tank* Court noted that several prior art patents in that case disclosed the use of manganese in welding compositions. 339 U.S. at 611. Further, the specification of the patent at issue in *Graver Tank* itself disclosed that manganese could be substituted for the claimed alkaline earth metals.⁷ 339 U.S. at 612 (Black, J. dissenting). See also *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046, 1065 (Fed. Cir. 2002) (Newman, J. dissenting) (noting that the accused manganese silicate welding flux at issue in *Graver Tank* "was disclosed in the [patent] specification but not claimed"). Accordingly, there is simply no question that the drafters of the patent at issue in *Graver Tank* "foresaw" that manganese could be substituted for the

seems akin to obviousness." *Id.* at 1063. Judge Lourie further noted that the concept of "foreseeability" would not simplify equivalence issues and make them more amenable to summary judgment, but rather that it would raise new factual issues, because "[d]etermining what is foreseeable would often require expert testimony as to what one skilled in the art would have foreseen." *Id.*

⁷ Notably, the specification of the '389 patent does teach the use of both rotational and translational motion of the movable end, to achieve "shifting" of the movable end relative to the seatbase (App. II-6, '389 patent, col. 3, lines 41-45), which movement Respondents' "fourth link" mimics.

alkaline earth metal required by the patent claims, inasmuch as they specifically disclosed that fact in the specification. Thus, under the Federal Circuit's "foreseeability" doctrine, a court considering the facts of *Graver Tank* could reach no other conclusion but that the doctrine of equivalents could not apply in that case – the opposite conclusion of that reached by this Court.

Similarly, in the case currently before this Court, this Court's holding in *Graver Tank* compels a different conclusion than that reached by the Federal Circuit. Indeed, as the Federal Circuit noted, the '389 patent "involves relatively simple and well-known technologies" (App. 25). The court further noted that the two named inventors of the '389 patent testified that they "were aware of other types of four bar mechanisms" (*Id.*) – presumably to suggest that the use of another type of "four bar mechanism" in the invention would (or should) have been "foreseeable" to those inventors.⁸ Moreover, Freedman presented evidence in the court below that persons skilled in the art would consider the "slider crank" type of "four bar mechanism" found in Freedman's preferred embodiment to be readily

⁸ While the Federal Circuit held that the claims of the '389 patent should not extend to "other four bar mechanisms" under the doctrine of equivalents because the inventors were "aware of other types of four bar mechanisms" (App. 25), the inventors' "awareness" of "other types" of four bar mechanisms does not conclusively establish that the inventors should have "foreseen" Respondents' use of the particular type of four bar mechanism employed in the accused EZ Fold seat. Thus, even if the Federal Circuit's "foreseeability" doctrine were not in direct conflict with this Court's precedent, Freedman respectfully submits that the inventors' testimony on this issue presents, at most, a genuine issue of material fact as to whether the structure employed in the EZ Fold seat would have been "foreseeable" at the time of the invention – an issue of fact which should have been resolved by a jury.

interchangeable with the "four bar mechanism" embodied in the accused EZ Fold seat.⁹

Under this Court's holding in *Graver Tank*, the known interchangeability between the two types of "four bar mechanisms" embodied in Freedman's patented seat and in the accused EZ Fold seat is an "important factor" weighing in favor of a finding of interchangeability – and thus equivalence between the patented and accused movable ends of the support member. Instead, the Federal Circuit applied its own "foreseeability" doctrine, to find that, because the inventors were aware of other "four bar mechanisms," they should have "foreseen" that a copyist would alter their novel seat design, by making an insubstantial change to the manner in which the movable end of the support member is mounted to the seatbase, and in which the movable end of the support member continued to move both rotationally and translationally relative to the seatbase. In so doing, however, the Federal Circuit did not even address this Court's precedent to the contrary, much less attempt to reconcile its holding with *Graver Tank*. As a result, the Federal Circuit's holding in this case is wholly inconsistent with this Court's decisions in *Graver Tank* and *Warner-Jenkinson*.

Accordingly, this Court should grant *certiorari* in order to correct the Federal Circuit's continued attempts to weaken the doctrine of equivalents, by holding that an accused element can escape equivalence if the particular

⁹ For instance, Freedman offered the report of its technical expert, Dr. Arthur Erdman, a professor of mechanical engineering, who opined that the two types of "four bar mechanisms" embodied by Freedman's patented seat and the accused EZ Fold seat were readily interchangeable.

alteration to the claimed element was somehow “foreseeable” to the patentee – a holding which directly conflicts with this Court’s precedent.

B. The Federal Circuit’s Finding of Non-Equivalence, Where the Accused Element Meets This Court’s “Function-Way-Result” Test for Equivalence, Conflicts Directly with the Decisions of This Court

In *Graver Tank*, this Court reaffirmed that the application of the doctrine of equivalents involves an analysis to determine whether an accused device “performs substantially the same function in substantially the same way to obtain the same result” as a patented device. 339 U.S. at 608 (citing *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)). In *Warner-Jenkinson*, this Court once again acknowledged this framework for determining equivalence, in the context of an element-by-element analysis, noting that “[a]n analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element.” 520 U.S. at 40. Thus, this Court’s precedence clearly establishes that the “function-way-result” test (also referred to in *Warner-Jenkinson* as the “triple identity” test, 520 U.S. at 39) may be used to establish that an accused element is equivalent to a claimed element.

The Federal Circuit has previously recognized the “function-way-result” test as a means of determining equivalence. See, e.g., *Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261, 1270 (Fed. Cir. 1999) (citing *Graver Tank*, 339 U.S. at 608, for the proposition

that “[t]he function-way-result test dictates that an element in the accused device is equivalent to the claim element if it ‘performs substantially the same function in substantially the same way to obtain the same result’”). However, in the case currently before this Court, the Federal Circuit effectively abandoned the “function-way-result” test, by finding, as a matter of law, that the accused movable end of the EZ Fold support member is not equivalent to the patented movable end – notwithstanding the Federal Circuit’s tacit acknowledgement that the accused movable end performs “substantially the same function in substantially the same manner to achieve substantially the same result” as the patented movable end, as the district court had held (App. 51).

The Federal Circuit conceded that both the accused EZ Fold seat and Freedman’s patented seat “provide the movable end of the support member with both translational and rotational motion relative to the seatbase” (App. 24). In so doing, the accused structure satisfied the “function-way-result” test, as expressly found by the district court (App. 51).¹⁰ Notably, the Federal Circuit did not

¹⁰ Specifically, Freedman set forth in its briefing below that the “function” served by the movable end of the support member is to mount the movable end to the seatbase, while permitting the seatbase to move from a horizontal (deployed) position to a vertical (stowed) position. There is no dispute in this case that both the accused and patented movable ends serve this function. Further, the “way” in which the movable end of the support member accomplishes this function is to provide the movable end of the support member with both translational and rotational motion relative to the seatbase – as specifically recited at col. 3, lines 41-45 of the ’389 patent (App. II-6). There is likewise no dispute in this case that both the accused and patented movable ends function in this way. Finally, the “result” obtained by the movable end of the support member is that the movable end is repositioned from a first position near the midpoint of the seatbase when the seatbase is stowed (vertical), to a

(Continued on following page)

dispute the district court's holding that the accused and patented structures satisfied the "function-way-result" test, thereby **conceding equivalence** under this Court's precedent. Rather than find the two structures to be equivalent, however, the court proceeded to create new law, by holding that it could disregard the function-way-result analysis entirely, on the purported basis that its result somehow "reads 'slidably mounted' completely out of the claims" (App. 24). The erroneousousness of this holding is bolstered by the fact that the specification of the '389 patent explicitly defines "slidably mounted" as "provid[ing] the opposite [movable] end of the diagonal truss [support member] with **translational and rotational motion**" (App. II-6, '389 patent, col. 3, lines 41-45).

In so doing, the Federal Circuit disregarded the precedent of this Court, which held in *Graver Tank* (and reaffirmed in *Warner-Jenkinson*) that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape." 339 U.S. at 608 (citing *Union Paper-Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877)). Under the current Federal Circuit holding, an accused element and a claimed element can perform the same function, in the same way, to accomplish the same result, and yet **not** be equivalent. Again, the Federal Circuit's holding serves to seriously weaken the

position near the aisle end of the seatbase when the seatbase is deployed (horizontal). Indeed, the fact that the "function-way-result" test is met in this case is clear from a review of the side-by-side comparison submitted by Freedman at p. 19 of its briefing below (App. II-9), showing the movement of both the accused and patented seats between the vertical (stowed) and horizontal (deployed) positions.

doctrine of equivalents, by enabling a copyist to escape infringement liability by making “unimportant and insubstantial changes” – the very conduct that the doctrine of equivalents was intended to prohibit. *Id.* at 607.

Accordingly, this Court should grant *certiorari* in order to correct the Federal Circuit’s attempt to yet again weaken the doctrine of equivalents, by requiring that court to consistently treat accused elements and claimed elements that perform “substantially the same function in substantially the same way to obtain the same result” – as a framework for determining equivalence, consistent with this Court’s holding in *Graver Tank*, 339 U.S. at 608.

CONCLUSION

For the reasons set forth above, this Petition for Writ of *Certiorari* should be granted in order to halt the Federal Circuit’s continued efforts to erode the protections of the doctrine of equivalents, which have previously required this Court’s prior intervention in both *Warner-Jenkinson* and *Festo*.

Respectfully submitted,

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App. 1

420 F.3d 1350

United States Court of Appeals,
Federal Circuit.

FREEDMAN SEATING COMPANY,
Plaintiff-Cross Appellant,

v.

AMERICAN SEATING COMPANY and **Hi-Tech Seating**
Products, Inc (doing business as **Kustom Fit**),
Defendants-Appellants.

Nos. 04-1216, 04-1248.

Aug. 11, 2005.

Richard D. Harris, Greenberg Traurig, LLP, of Chicago, Illinois, argued for plaintiff-cross appellant. With him on the brief were Herbert H. Finn and Jeffrey P. Dunning.

Todd R. Dickinson, Fisher & Dickinson, of Ada, Michigan, argued for defendants-appellants. Of counsel on the brief were Conrad J. Clark and Christopher W. Brody, Clark & Brody, of Washington, DC.

Before **MAYER**, Circuit Judge, **PLAGER**, Senior Circuit Judge, and **SCHALL**, Circuit Judge.

SCHALL, Circuit Judge.

This is a patent infringement case. **Freedman Seating Company** ("Freedman") sued **American Seating Company** and **Hi-Tech Seating Products** (doing business as **Kustom Fit**) (collectively, "**American Seating**") in the United States District Court for the Central District of California for infringement of U.S. Patent No. 5,492,389 (issued Feb. 20, 1996) ("*the '389 patent*") and for unfair competition in violation of the Lanham Act, 15 U.S.C. § 1125 (2000). The district court granted summary judgment in favor of **Freedman** both on the issue of infringement under the doctrine of equivalents

and on American Seating's counterclaim of invalidity by reason of obviousness. *Freedman Seating Co. v. Am. Seating Co.*, No. CV-02-5347 (C.D.Cal. Oct. 24, 2003) ("Summary Judgment I"). The court granted summary judgment in favor of American Seating, however, on Freedman's Lanham Act claim. *Id.* After American Seating filed a motion for reconsideration, the district court also granted summary judgment in favor of Freedman on American Seating's affirmative defense of unenforceability based upon inequitable conduct. *Freedman Seating Co. v. Am. Seating Co.*, No. CV-02-5347 (C.D.Cal. Nov. 18, 2003) ("Summary Judgment II"). A jury trial subsequently was held to determine damages, the jury ultimately awarding Freedman \$163,155.20 in lost profits from American Seating Company and \$14,800.00 in royalties from Kustom Fit. *Freedman Seating Co. v. Am. Seating Co.*, No. CV-02-5347 (C.D.Cal. Jan. 12, 2004) ("Judgment on Jury Verdict").

American Seating now appeals all aspects of the district court's summary judgment decision that were unfavorable to it. Freedman, in turn, cross-appeals the district court's ruling allowing American Seating to invoke the advice of counsel defense to Freedman's charge of willful infringement, the jury's finding of no willful infringement and its calculation of damages, and the district court's refusal to award costs and prejudgment interest.¹ Because we conclude that the judgment of infringement under the doctrine of equivalents has the effect of vitiating a limitation of the claims of the '389 patent, we reverse the judgment and remand the case to the district court with instructions to enter judgment of non-infringement in

¹ Freedman does not appeal the district court's ruling on its Lanham Act claim.

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favor of American Seating. Because we conclude that genuine issues of material fact remain as to obviousness, we also reverse the district court's grant of summary judgment of validity and remand for further proceedings. We do not reach the other issues raised on appeal.

BACKGROUND

I.

A.

Freedman manufactures seats used in public transportation vehicles. Its product line includes stowable seats, which are seats that have the ability to fold away in order to create more interior space in a vehicle. They are particularly useful for accommodating passengers with wheelchairs, but may be used whenever more interior space is needed.

Freedman also owns *the '389 patent*, titled "Stowable Seat." The figures shown below are representative of the stowable seat claimed in *the '389 patent*.

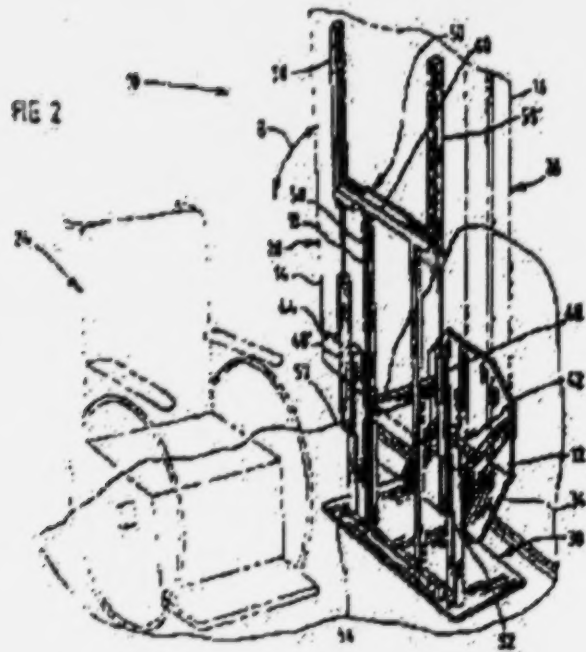
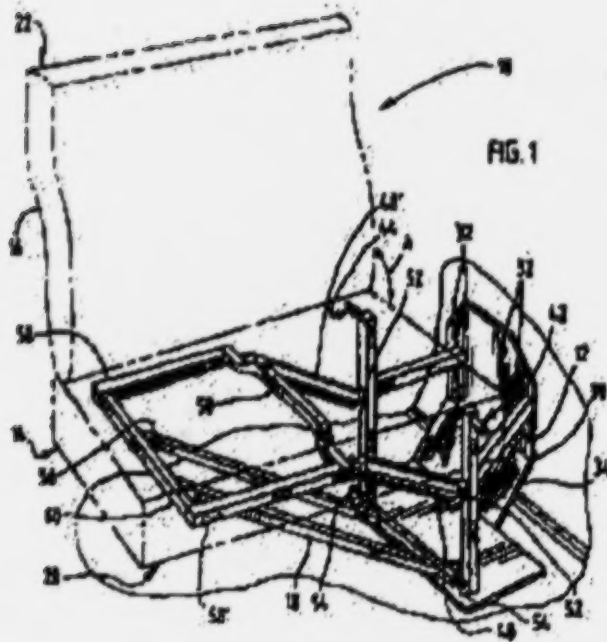


Figure 1 shows the stowable seat (10) in the horizontal (or deployed) position, while figure 2 shows the stowable seat

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in the vertical (or stowed) position. Moving the seat from its horizontal to vertical position involves "folding the seatback (16) flat against the seatbase (14), unlocking the seatbase from its horizontally deployed position and raising the seatbase to its vertically stowed position where it is locked in place." '389 patent, col. 1, ll. 19-24 (numerals added).

As shown by figure 1, the invention of *the '389 patent* does not use an aisle leg to support the seat when in the horizontal position. *See id.* col. 1, ll. 8-14; col. 3, ll. 32-34. Rather, the invention is based on a cantilever design, which uses a diagonal truss (18), also referred to as a support member, to support the aisle-end of the seat when in the horizontal position. This design, according to *the '389 patent*, avoids difficulties attendant with stowing and deploying seats that have a separate aisle leg. *Id.* col. 1, ll. 25-35.

In addition to providing aisle support, the diagonal truss allows for translational movement of the seatbase between the horizontal and vertical positions. This is due to the truss having a fixed end that is attached to the seat's frame (12) at a pivot point (54), and a movable end (56) that is "slidably mounted" in a runner track (58). *Id.* col. 3, ll. 40-47. When stowing the seat, the movable end of the diagonal truss slides on the runner track toward the middle of the seatbase, while the fixed end of the diagonal truss rotates upward until the seat is in the vertical position. Similarly, when the seat is deployed again, the movable end of the diagonal truss slides toward the aisle end of the seatbase, while the fixed end rotates downward until the seat is in the horizontal position. This folding mechanism created by the slidably mounted moveable end is known in the field of mechanical engineering as a "slider crank," which is a particular type of "four bar mechanism."

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Claim 1 is representative of the claims asserted against American Seating; it reads:

A stowable seat for mounting to support member of a vehicle wherein a space may be selectively provided for positioning an article adjacent to the stowable seat, when stowed the seat comprising:

a frame attached to a support member;

a cantilevered seatbase having a free end, a pivotable end including a pivot mounted thereto for rotatably associating said pivotable end with said frame and for providing said seatbase with a range of motion extending from a horizontally deployed position to a vertically stowed position, a support member for supporting said seatbase in said deployed position including a moveable end **slidably mounted** to said seatbase and a fixed end journaled with said frame, and a first lock near said free end for releasably locking said movable end to maintain said seatbase in said deployed position; and

a seatback having a pivot for rotatably associating said seatback with said seatbase and for providing said seatback with a range of motion extending from an unfolded position to a folded position, said range of motion of said seatback being perpendicular to said range of motion of said seatbase, said seatback in said unfolded position adapted to be a predetermined angle with respect to said seatbase in said deployed position to provide seating and said seatback in said folded position adapted to be adjacent said seatbase for stowing to provide the space for the article.

(Emphasis added).

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B.

American Seating Company and Kustom Fit also manufacture and market seating products for the transportation industry. One particular seat is the Horizon EZ Fold ("EZ Fold"), which is a stowable seat manufactured by Kustom Fit and sold by American Seating Company. The EZ Fold is in many respects similar, if not identical, to the invention claimed in *the '389 patent*. Most notably, neither device has an aisle leg. However, and important to this case, the two products use different types of support structures in lieu of the aisle leg. The invention claimed in *the '389 patent*, of course, uses the slider crank, which is described in part by the "slidably mounted" limitation. The EZ Fold, on the other hand, uses what is known as a "fourth link."

Like the slider crank, the fourth link is also a specific type of four bar mechanism. However, the two mechanisms differ in that, where the moveable end of *the '389 patent's* support member is slidably mounted to the seatbase, the moveable end of the EZ Fold's support member is rotatably mounted to the seatbase. Therefore, the moveable end of the EZ Fold's support member does not slide or otherwise move along the seatbase. Rather, its only range of motion consists of rotation throughout its revolute joints. That said, the EZ Fold's fourth link mechanism still provides the seatbase with fluid translational motion, and thereby allows the seat to fold between the deployed and stowed positions. It does this through an extra set of revolute joints located in the midsection of its support member ("mid-joints"). These mid-joints are shown below in two representative illustrations of the EZ Fold product.



The illustration on the left shows the seat in the fully deployed position, and the illustration on the right shows the device in transition between the deployed and stowed positions.

II.

On July 5, 2002, Freedman sued both American Seating Company and Kustom Fit for patent infringement

and unfair competition under the Lanham Act. With respect to the claim for patent infringement, Freedman alleged that American Seating Company's EZ Fold infringed *the '389 patent*. Freedman alleged that Kustom Fit also infringed as a result of its role in developing and manufacturing the EZ Fold for American Seating Company. In response to Freedman's complaint, American Seating denied Freedman's allegations of patent infringement and unfair competition, and also asserted a counterclaim of patent invalidity by reason of obviousness. After some discovery, American Seating requested leave to amend its answer. The district court granted this request on September 4, 2003, for the limited purpose of allowing American Seating to add an affirmative defense of unenforceability by reason of inequitable conduct.

In due course, both parties filed motions for summary judgment on the issue of infringement. Freedman also moved for summary judgment of validity of *the '389 patent*, and American Seating moved for summary judgment on Freedman's unfair competition claim. With respect to the issue of infringement, the court stated that there really was no dispute as to claim construction or the structure of the accused product. *Summary Judgment I*, slip op. at 9. In fact, the parties generally agreed that the EZ Fold literally meets all of the limitations of claim 1 except for the limitation requiring that the movable end of the support member be "slidably mounted" to the seatbase. *Id.* The accused product does not literally meet this limitation because the EZ Fold's support member is rotatably mounted, not slidably mounted, to the seatbase. *Id.* The district court therefore identified the sole issue before it as "whether *the '389 Patent's* support member and movable end is equivalent to that found in the accused device." *Id.*

American Seating argued that its support member and moveable end were not equivalent to the corresponding structure claimed by *the '389 patent* because its system used a fourth link, which created a substantially different support structure than the slider crank of *the '389 patent*. *Id.* at 10. In particular, American Seating argued that the support structures of the two devices created substantially different distribution forces. The district court disagreed. As an initial matter, the court stated that force distributions were not claimed in *the '389 patent* and were therefore of minimal relevance. *Id.* at 11. In addition, the court found that any difference in force distributions was insubstantial, and that Freedman's "slider-crank and [American Seating's] fourth link perform substantially the same function in substantially the same manner to achieve substantially the same result." *Id.* The court therefore granted Freedman summary judgment of infringement by equivalence. *Id.* at 11-12.

As to the issue of invalidity, American Seating opposed Freedman's motion for summary judgment on the ground that, at a minimum, there were genuine issues of material fact as to whether the invention of *the '389 patent* was obvious. Again, the district court disagreed. The court determined that the closest piece of prior art, U.S. Patent No. 5,489,141 ("the C.E. White reference"), which used an aisle leg, did not disclose or otherwise teach a folding chair having a cantilever design. *Id.* at 7. Furthermore, while other prior art references disclosed cantilever designs, the court found that American Seating did not "present information that clearly and convincingly demonstrates obviousness of *the '389 Patent* resulting from the existence of 'a reason, suggestion, or motivation in the prior art or elsewhere that would lead one of ordinary skill in the art

to combine'” the C.E. White reference with prior art cantilever designs. *Id.* at 8. Therefore the district court held that no reasonable juror could conclude that the '389 patent was invalid and, accordingly, granted Freedman summary judgment of validity. *Id.* The court also seemed to reject American Seating's unenforceability defense, finding that the subject matter taught by the C.E. White reference was adequately disclosed in the Background of the '389 patent. *Id.*² Finally, the district court granted American Seating summary judgment on Freedman's unfair competition claim. *Id.* at 12-13.

American Seating subsequently sought reconsideration on the grounds that the district court had improperly granted summary judgment on the issue of validity and had failed to consider American Seating's affirmative defense of inequitable conduct. *Freedman Seating Co. v. Am. Seating Co.*, No. CV-02-5347, slip op. at 15-16 (C.D.Cal. Nov. 13, 2003). The district court denied the motion with respect to the issue of validity, but granted the motion with respect to inequitable conduct. *Id.* at 5. Nevertheless, after the parties submitted additional briefing, the court granted Freedman summary judgment of no inequitable conduct. *Summary Judgment II*, slip op. at 5.

Having concluded that American Seating infringed a valid and enforceable patent owned by Freedman, the district court held a jury trial to determine the amount of any resulting damages. The jury concluded that American

² American Seating argued that the applicants for the '389 patent had engaged in inequitable conduct during prosecution by failing to disclose to the examiner the C.E. White reference.

Seating's infringement was not willful and awarded Freedman \$177,955.20 in damages, \$163,155.20 of which was computed based on lost profits from American Seating Company, and \$14,800 of which was based on a reasonable royalty from Kustom Fit. The district court subsequently denied Freedman's request for costs and attorney's fees and entered final judgment. *Judgment on Jury Verdict.*

American Seating timely appealed to this court and Freedman has cross-appealed. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

DISCUSSION

In the main appeal, American Seating contends that the district court erred in granting summary judgment for Freedman on the issues of infringement, validity, and enforceability. Freedman responds that the district court properly granted summary judgment on these issues. However, in its cross-appeal, Freedman contends that the district court committed several errors at the damages phase of the litigation. In particular, Freedman contends that the district court erred in allowing American Seating to invoke the advice of counsel defense to the charge of willful infringement and in refusing to award costs and pre-judgment interest. Freedman also contends that the jury's finding of no willful infringement is not supported by substantial evidence and that the jury further erred by not awarding damages for all acts of infringement.³

³ As noted above, Freedman does not appeal the district court's grant of summary judgment in favor of American Seating on the Lanham Act claim.

We begin by addressing American Seating's appeal, for if American Seating is not liable for patent infringement, there is no reason to consider Freedman's cross-appeal regarding damages.

I.

We review summary judgment decisions *de novo*, reapplying the standard used by the district court. *Frank's Casing Crew & Rental Tools, Inc. v. Weatherford Int'l, Inc.*, 389 F.3d 1370, 1376 (Fed.Cir.2004); *Ellison v. Robertson*, 357 F.3d 1072, 1075 (9th Cir.2004). Under that standard, summary judgment must be granted "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c). In other words, summary judgment must be granted if no "reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). In making this determination, "[t]he evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in [the non-movant's] favor." *Id.* at 255, 106 S.Ct. 2505.

II.

Patent infringement is a two step inquiry. First, the court must construe the asserted claim. *RF Del., Inc. v. Pac. Keystone Techs., Inc.*, 326 F.3d 1255, 1266 (Fed.Cir.2003). Second, the court must determine whether the accused product or process contains each limitation of the properly construed claims, either literally or by a substantial

equivalent. *Id.* The first step is a question of law; the second step is a question of fact. *Id.*

A.

On appeal, American Seating contends that the district court's grant of summary judgment of infringement had the effect of vitiating the claim limitation requiring that the moveable end of the support member be "slidably mounted to said seatbase." That, according to American Seating, is because while the claims of the '389 patent unequivocally state that the moveable end is "slidably mounted," the moveable end of the EZ Fold is rotatably mounted using revolute joints. In addition, American Seating argues that, at the time of filing for the '389 patent, the interchangeability of four bar mechanisms was foreseeable to one of skill in the art. American Seating states that this is significant because, while Freedman could have chosen to claim a fourth link mechanism (or even all types of four bar mechanisms), it chose to narrowly claim a slider-crank mechanism. American Seating contends that competitors should therefore be entitled to rely on this clear structural limitation without risk of infringement under the doctrine of equivalents. American Seating further argues that, even if the district court's finding of infringement would not vitiate the claim limitation, it presented evidence to the district court showing that the EZ Fold's fourth link is substantially different from the slider crank claimed in the '389 patent.

In response, Freedman contends that the district court properly granted summary judgment of infringement. Freedman states that, contrary to American Seating's assertions, the district court did not read "slidably

mounted" out of the claims. Rather, the district court merely concluded that the rotatably mounted support member (or fourth link) of the accused product was equivalent to a slidably mounted support member (or slider crank). Freedman asserts that the district court reached this conclusion by properly applying the function-way-result test for equivalence set forth in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097 (1950). First, Freedman asserts that in both the accused product and the '389 patent, mounting the support member to the seatbase serves the function of attaching the moveable end of the support member to the seatbase while still permitting the seatbase to move between the horizontal and vertical positions. Second, Freedman asserts that the '389 patent and the accused product perform this function in the same way, by providing the movable end of the support member with both translational and rotational motion relative to the seatbase. Finally, Freedman asserts that both devices achieve the same result, namely, "the repositioning of the movable end, from a first position near the midpoint of the seatbase when the seatbase is stowed, to a position near the aisle end of the seatbase when the seatbase is deployed."

B.

Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21, 117 S.Ct. 1040, 137

L.Ed.2d 146 (1997) (citing *Graver Tank*, 339 U.S. at 609, 70 S.Ct. 854). The doctrine evolved in recognition of the fact that

[t]he language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying.

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 731, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002); *Graver Tank*, 339 U.S. at 605, 70 S.Ct. 854 (“[T]o permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing.”). At the same time, the doctrine of equivalents necessarily adds uncertainty to the scope of patent claims, and thereby detracts from the public-notice function of patent claims and risks deterring non-infringing and potentially innovative endeavors. See *Festo*, 535 U.S. at 727, 122 S.Ct. 1831 (“If the range of equivalents is unclear, competitors may be unable to determine what is a permitted alternative to a patented invention and what is an infringing equivalent.”); *Warner-Jenkinson*, 520 U.S. at 29, 117 S.Ct. 1040 (“There can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirements.”). In recognition of this risk, and in an effort to strike the proper balance between protecting patentees while also providing sufficient notice to the public, various rules of

law have emerged to constrain when and how the doctrine of equivalents is to be applied.

Of relevance to this case is the "all limitations" rule.⁴ The rule holds that an accused product or process is not infringing unless it contains each limitation of the claim, either literally or by an equivalent. See, e.g., *Warner-Jenkinson*, 520 U.S. at 29, 117 S.Ct. 1040; *Kustom Signals, Inc. v. Applied Concepts, Inc.*, 264 F.3d 1326, 1333 (Fed.Cir.2001). This principle has two primary implications for the doctrine of equivalents. First, the all limitations rule requires that equivalence be assessed on a limitation-by-limitation basis, as opposed to from the perspective of the invention as a whole. *Warner-Jenkinson*, 520 U.S. at 29, 117 S.Ct. 1040 ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole."); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 935 (Fed.Cir.1987) (*en banc*). Second, an element of an accused product or process is not, as a matter of law, equivalent to a limitation of the claimed invention if such a finding would entirely vitiate the limitation. *Warner-Jenkinson*, 520 U.S. at 29, 117 S.Ct. 1040 ("It is important to ensure that the application of the doctrine [of equivalents], even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.");

⁴ There are other constraints not relevant to this appeal, such as the doctrine of prosecution history estoppel, see generally *Festo*, 535 U.S. at 733-41, 122 S.Ct. 1831, and the rule of subject matter dedication, see generally *Johnson & Johnston Assocs. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046 (Fed.Cir.2002) (*en banc*).

Lockheed Martin Corp. v. Space Sys./Loral, Inc., 324 F.3d 1308, 1321 (Fed.Cir.2003) (“[I]f a court determines that a finding of infringement under the doctrine of equivalents ‘would entirely vitiate a particular claim[ed] element,’ then the court should rule that there is no infringement under the doctrine of equivalents.” (citation omitted)); *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1279-80 (Fed.Cir.2001) (same).

There is no set formula for determining whether a finding of equivalence would vitiate a claim limitation, and thereby violate the all limitations rule. Rather, courts must consider the totality of the circumstances of each case and determine whether the alleged equivalent can be fairly characterized as an insubstantial change from the claimed subject matter without rendering the pertinent limitation meaningless. *See, e.g., Novartis Pharm. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1338-39 (Fed.Cir.2004) (“Permitting such an element in the accused product to come within the bounds of the claimed element would impermissibly extend the scope of the claim language beyond what the patentee actually claimed.”); *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed.Cir.2000) (“If our case law on the doctrine of equivalents makes anything clear, it is that all claim limitations are not entitled to an equal scope of equivalents.”); *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1317-21 (Fed.Cir.1998) (indicating that assessing infringement under the doctrine of equivalents is dependent on the facts of each case); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425 (Fed.Cir.1997) (“Because th[e] issued patent contains clear structural limitations, the public has a right to rely on those limits in conducting its business activities.”).

Our decision in *Ethicon* provides a good example of the multi-factored analysis required by the doctrine of equivalents. In that case, Ethicon Endo-Surgery, Inc. ("Ethicon") sued U.S. Surgical Corp. ("U.S. Surgical") for infringement of claims 6 and 24 of U.S. Reissue Patent No. 34,519. 149 F.3d at 1311. The patent related to surgical staplers and, specifically, a "lockout mechanism" used to prevent the user from discharging the stapler without first inserting a new staple cartridge. *Id.* The claimed lockout mechanism was located within the staple cartridge and, in short, worked by blocking the stapler's pusher bar from firing. *See id.* at 1313. Claims 6 and 24 differed in the specific location of the lockout mechanism. Claim 6 stated that the lockout mechanism was "connected to . . . [the] longitudinal slots" located in the cartridge, whereas in claim 24, the lockout mechanism was merely located somewhere in the path of the pusher bar. *Id.*

The accused product did not literally infringe claim 6 or claim 24, because its lockout mechanism did not "obstruct the pusher bars' path into the cartridge, but rather, prevent[ed] the bars from being pushed from behind by obstructing the movement of the cam bar retainers." *Id.* In addition, "the [lockout mechanism was] held out of the path of the pusher assembly . . . until just before the first staple [was] fired. . . . [B]y the time the first staple [was] fired, the [lockout mechanism was] in contact with the cam bar retainer," thereby preventing a second firing. *Id.* Based on these differences, the district court concluded that there was, as a matter of law, no infringement under the doctrine of equivalents, and therefore granted U.S. Surgical summary judgment of non-infringement of both claim 6 and 24. *Id.* at 1314-15.

On appeal, we affirmed summary judgment as to claim 6, but reversed the grant of summary judgment as to claim 24. *Id.* at 1321. With respect to claim 6, we agreed with the district court that the "connected to said longitudinal slots" limitation "ties the lockout mechanism to a specific place" – namely, to the slots, which were located inside of the chamber. *Id.* at 1318 (citation omitted). In U.S. Surgical's product, however, the lockout mechanism was "located at the distal end of the [disposable loading unit,] nowhere near the longitudinal slots which [were] located in the staple cartridge at the front end of the stapler." *Id.* Therefore, because U.S. Surgical's lockout mechanism was located outside of the cartridge and nowhere near the longitudinal slots, we concluded that no reasonable juror could find equivalence, i.e., an insubstantial difference. *Id.* at 1318-19.

On the other hand, the pertinent limitation of claim 24 merely stated that the lockout mechanism was located somewhere in the path of the pusher assembly, *id.* at 1312-13, and the accused product's lockout mechanism was located in the path of the pusher assembly. However, there could be no literal infringement because, where the claimed lockout mechanism always "contact[ed] the [pusher assembly] 'during staple firing,'" the accused product's lockout mechanism "los[t] contact with the [pusher assembly] just prior to staple firing," and then regained contact after firing, thereby preventing a second firing. *Id.* at 1321. Nonetheless, we found that "this physical difference translates into a 'very slight,' 'very quick' temporal difference, a period that is perhaps as short as a few thousandths of a second." *Id.* We further concluded that this subtle difference left genuine issues of material fact as to infringement under the doctrine of

equivalents. *Id.* at 1320-21. In doing so, we explained that our finding did not vitiate any limitations of claim 24 because the noted difference "is a *subtle difference in degree*, not a clear, *substantial difference* or *difference in kind*, as was the case regarding claim 6." *Id.* at 1321 (emphases added); see also *Wright Med. Tech., Inc. v. Osteonics Corp.*, 122 F.3d 1440, 1445 (Fed.Cir.1997) (holding that a finding of infringement under the doctrine of equivalents would not vitiate the "closely fit" and "extend through" limitations of the asserted claims).

Conversely, in *Sage Products* we affirmed the district court's grant of summary judgment of non-infringement under the doctrine of equivalents. 126 F.3d at 1421. One of the asserted patents described a container for discarding syringes and other like materials and claimed, among other things, "an elongated slot at the top of the container body" and a barrier means comprised of "a first constriction extending over said slot." *Id.* at 1422. We agreed that the district court properly interpreted "top of the container body" to mean "highest point, level, or part of." *Id.* at 1423. The accused product differed from the claimed invention in that the slot was located in the interior of the container rather than at the top of the container. *Id.*

We concluded that finding infringement under these circumstances would vitiate the "slot at the top of the container body" and "extending over said slot" limitations. *Id.* at 1424-26. We reached our conclusion based on several considerations, including the simplicity of the structure, the specificity and narrowness of the claim, and the foreseeability of variations at the time of filing the claim with the PTO:

The claim at issue defines a relatively simple structural device. A skilled patent drafter would foresee the limiting potential of the "over said slot" limitation. No subtlety of language or complexity of the technology, nor any subsequent change in the state of the art, such as later-developed technology, obfuscated the significance of this limitation at the time of its incorporation into the claim. If [the patentee] desired broad patent protection for any container that performed a function similar to its claimed container, it could have sought claims with fewer structural encumbrances. . . . Instead, [the patentee] left the PTO with manifestly limited claims that it now seeks to expand through the doctrine of equivalents. However, as between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.

Id. at 1425 (citation and footnote omitted). Compare *Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1475 (Fed.Cir.1998) ("This is a case in which a 'subsequent change in the state of the art, such as later-developed technology, obfuscated the significance of [the] limitation at the time of its incorporation into the claim.'").

In *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed.Cir.1998), we similarly concluded that a finding of equivalence would vitiate the claimed limitation. The asserted claims related to an artificial hip socket and included a limitation requiring that the prosthesis's body have "a generally conical outer surface." *Id.* at 1156. In finding infringement, the jury concluded that the hemispherical shape of the accused product's hemispherical cup was equivalent to the

“generally conical outer surface” limitation. *Id.* We reversed, finding no infringement as a matter of law. We were particularly troubled by expert testimony submitted by the plaintiff, Tronzo, stating that “when either a hemispherical cup or trapezoidal cup or any other shape cup is successfully implanted into the body, it functions almost exactly the same way.” *Id.* at 1160 (emphasis in original). We stated that, according to this theory of infringement, “any shape would be equivalent to the conical limitation.” *Id.* (emphasis added). “Such a result,” we concluded, “is impermissible under the all-elements rule of *Warner-Jenkinson* because it would write the ‘generally conical outer surface’ limitation out of the claims.” *Id.*; see also *Asyst Techs., Inc. v. Emtrak, Inc.*, 402 F.3d 1188, 1195 (Fed.Cir.2005) (holding that, under the “specific exclusion” principle, “the term ‘mounted’ can fairly be said to specifically exclude objects that are ‘unmounted’”); *Moore U.S.A.*, 229 F.3d at 1106 (“[T]o allow what is undisputedly a minority (i.e., 47.8%) to be equivalent to a majority would vitiate the requirement that the ‘first and second longitudinal strips of adhesive . . . extend the majority of the lengths of said longitudinal marginal portions.’”).

In the instant case, we think the district court’s finding of infringement under the doctrine of equivalents had the effect of entirely vitiating the “slidably mounted” limitation. The parties agree that all of the claims require a support member having “a moveable end slidably mounted to” the seatbase. See, e.g., ’389 patent, claim 1 & claim 5.⁵ It is also not disputed that the moveable end of

⁵ Independent claim 16 uses slightly different language -- “a diagonal support member . . . including a moveable end slidably received by a longitudinal guide member affixed to an underside of said

(Continued on following page)

the EZ Fold's support member is rotatably mounted, not slidably mounted, to the seatbase. Therefore, while the moveable end of the EZ Fold's support member has the ability to rotate, it cannot slide or otherwise move along the seatbase. It is confined to a fixed location. We think that this structural difference in the mounting of the moveable end to the seatbase is not a "subtle difference in degree," but rather, "a clear, substantial difference or difference in kind." *Ethicon*, 149 F.3d at 1321.

Freedman argues that the slider crank claimed in the '389 patent and the fourth link mechanism used in the EZ Fold function in the same way to produce identical results. (Br. of Appellee at 17-21.) Freedman asserts that this is because "[b]oth the infringing seat and the claimed structure of the '389 patent provide the moveable end of the support member with both translational and rotational motion relative to the seatbase." (*Id.* at 18.) The problem, however, is that taken to its logical conclusion, Freedman's argument would mean that any support member capable of allowing translational and rotational motion would be equivalent to a support member "slidably mounted to said seatbase," which reads "slidably mounted" completely out of the claims. This is the precise type of overextension of the doctrine of equivalents that the claim vitiation doctrine is intended to prevent. Indeed, we rejected this same type of argument in *Tronzo*. See 156 F.3d at 1160 (holding that finding all shapes to be equivalent structure would entirely vitiate [sic] the limitation requiring a "generally conical shape" (emphasis added)).

seatbase" – but the parties do not argue that this difference is relevant to the disputed issue in the case.

Freedman's theory of infringement also suffers from some of the same problems we addressed in *Sage Products*. In particular, though elegant, the subject matter claimed by the '389 patent involves relatively simple and well-known technologies. The patentees also stated that they were aware of other types of four bar mechanisms. (See June 10, 2003 Dep. of Michael D. Moffa at 89-95; June 9, 2003 Dep. of Brian W. McClintock at 46-47.) Yet, they chose to specifically limit the claims to slider-crank mechanisms vis-à-vis the "slidably mounted" moveable end limitation. Members of the public were therefore justified in relying on this specific language in assessing the bounds of the claim. Accordingly, we think that to now say the claims include other four bar mechanisms under the doctrine of equivalents would unjustly undermine the reasonable expectations of the public. See *Sage Prods.*, 126 F.3d at 1425 ("Given a choice of imposing the higher costs of careful prosecution on patentees, or imposing the costs of foreclosed business activity on the public at large, this court believes the costs are properly imposed on the group best positioned to determine whether or not a particular invention warrants investment at a higher level, that is, the patentees."); see also *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556, 1562 (Fed.Cir.1994) ("The doctrine of equivalence cannot be used to erase 'meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement.'" (citation omitted)).

In sum, we hold that the district court's finding of infringement entirely vitiated the "slidably mounted" limitation of the '389 patent. We therefore reverse the court's grant of summary judgment and remand with

instructions to enter judgment of non-infringement in favor of American Seating.

III.

Although we have now determined that American Seating's EZ Fold does not infringe the '389 patent, we must nevertheless address the invalidity counterclaim per the Supreme Court's decision in *Cardinal Chemical Co. v. Morton International, Inc.*, 508 U.S. 83, 113 S.Ct. 1967, 124 L.Ed.2d 1 (1993).⁹ On appeal, American Seating makes two primary arguments as to why the district court erred in granting Freedman summary judgment of validity. First, American Seating contends the district court applied an incorrect obviousness standard by equating obviousness with "indistinguishable." Second, American Seating contends that the district court improperly placed the burden of proving obviousness on American Seating, the nonmoving party. As the nonmoving party, American Seating argues that it only needed to show the existence of genuine issues of material fact in order to defeat Freedman's motion for summary judgment, a burden that American Seating asserts to have satisfied. We agree with American Seating on both points.

⁹ On the other hand, we need not address the issue of enforceability. American Seating asserted that issue not as a counterclaim for a declaratory judgment, but rather, as an affirmative defense to Freedman's charge of infringement. Therefore, having concluded that American Seating does not infringe the '389 patent, and having further directed the district court to enter judgment of non-infringement, there is no reason for us to consider American Seating's affirmative defense, as it would have no effect on the scope of the judgment. See *TypeRight Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151, 1156-57 (Fed.Cir.2004).

Although at times the district court referred to the obviousness standard set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), at other times the court appeared to equate obviousness with "indistinguishable." *Summary Judgment I*, slip op. at 7 ("A patent is 'obvious,' i.e., indistinguishable, 'if the difference between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.'" (citation omitted)); *id.* ("Defendants have not provided evidence that demonstrates the '389 Patent is obvious and indistinguishable from prior art."). This not the correct perspective from which to assess obviousness. Indeed, a claim that is obvious is, by definition, "distinguishable" from the prior art. See *Graham*, 383 U.S. at 17-18, 86 S.Ct. 684 (stating that an obviousness analysis requires, among other things, assessing the differences between the claimed invention and the prior art). The reason such a claim is nonetheless invalid is because its differences over the prior art are simply not sufficient to warrant a patent grant. Therefore, the district court erred to the extent it held that the '389 patent could only be invalid for obviousness if indistinguishable from the prior art.

In addition, it appears that the district court erred by treating American Seating, not Freedman, as the party moving for summary judgment. In particular, the court repeatedly stated that summary judgment for Freedman was appropriate because American Seating had failed to prove invalidity by clear and convincing evidence. For example, the court stated: "In light of Defendants failure to prove invalidity through obviousness or otherwise, this Court concludes that Plaintiff's '389 Patent is valid."

Summary Judgment I, slip op. at 8; see also *id.* at 7 ("Defendants have not provided evidence that demonstrates the '389 patent is obvious and indistinguishable from prior art."); *id.* at 8 ("Defendants do not present information that clearly and convincingly demonstrates obviousness of the '389 Patent. . ."); *id.* ("In sum, Defendants fail to meet their burden of establishing validity."). However, it was Freedman who moved for summary judgment. Therefore, American Seating only needed to show the existence of a genuine issue of material fact in order to preclude summary judgment for Freedman. *Liberty Lobby*, 477 U.S. at 252, 106 S.Ct. 2505 (holding that once the moving party makes a *prima facie* showing in support of its motion for summary judgment, the nonmoving party must come forward with evidence sufficient to show a genuine issue of material fact). We think American Seating came forward with such evidence.

It is undisputed that the C.E. White reference disclosed all of the limitations of the claimed invention except for the cantilevered seatbase. (The C.E. White reference used an aisle leg instead of a cantilever.) However, American Seating presented evidence showing that cantilevered seats were in the prior art. (See June 10, 2003 Dep. of Michael D. Moffa at 89-95; June 9, 2003 Dep. of Brian W. McClintock at 46-47.) American Seating also offered evidentiary support for its assertion that the invention of the '389 patent occurred only after one of the inventors, Brian W. McClintock, was given the specific assignment of modifying the C.E. White seat to eliminate the aisle leg. (June 9, 2003 Dep. of Brian W. McClintock at 16-18.) We think that this record, although not clearly and convincingly demonstrating obviousness, was sufficient to create a genuine issue of material fact as to whether one of skill in

the art would have been motivated to combine the C.E. White reference with a suitable cantilever device from the prior art. Accordingly, we reverse the district court's grant of Freedman's motion for summary judgment of validity and remand for further proceedings.

CONCLUSION

Because we hold that finding infringement under the doctrine of equivalents would have the effect of vitiating the "slidably mounted" limitation of *the '389 patent*, we reverse the district court's summary judgment of infringement in favor of Freedman and remand with instructions to enter judgment for American Seating of non-infringement. Because we hold that genuine issues of material fact exist as to obviousness, we reverse the district court's grant of Freedman's motion for summary judgment of validity and remand for further proceedings. Based on our finding of non-infringement as a matter of law, we do not reach American Seating's affirmative defense of unenforceability or the issues related to damages raised in Freedman's cross-appeal.

COSTS

Each party shall bear its own costs.

REVERSED and *REMANDED*

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CIVIL MINUTES – GENERAL

Case No. CV 02-5347 RGK (RNBx) Date: October 23, 2003

Title: FREEDMAN SEATING CO. v. AMERICAN SEATING
CO., et al.

**PRESENT: THE HONORABLE R. GARY KLAUSNER,
U.S. DISTRICT JUDGE**

Sharon L. Williams
Courtroom Clerk

Not Reported
Court Reporter

**ATTORNEY(S) PRESENT
FOR PLAINTIFFS:**

**ATTORNEY(S) PRESENT
FOR DEFENDANTS:**

None Present

None Present

**PROCEEDINGS: ORDER (1) GRANTING PLAINTIFF'S
MOTION FOR PARTIAL SUMMARY
JUDGMENT [DE 40] AND (2) GRANT-
ING IN PART AND DENYING IN
PART DEFENDANTS' MOTION FOR
PARTIAL SUMMARY JUDGMENT [48]**

I. FACTUAL BACKGROUND

This action is brought by Plaintiff Freedman Seating Co. ("Plaintiff" or "Freedman") against Defendants American Seating Company ("American Seating") and Kustom

Fit Hi-Tech Seating Products, Inc.¹ ("Hi-Tech Seating") (collectively, "Defendants") for:

- (1) Patent Infringement; and
- (2) Unfair Competition under the Lanham Act.

Plaintiff seeks injunctive relief pursuant to the Patent Act (35 U.S.C. §271(a), (b), (c), and (f)) and the Lanham Act (15 U.S.C. §1125(a)).

Plaintiff is the owner of U.S. Patent No. 5,492,389 ("389 Patent") for a Stowable Seat. Plaintiff alleges that Defendants contracted to manufacture seating products that infringe on Plaintiff's patent. Defendants have sold and continue to sell the alleged infringing products.

Additionally, Plaintiff alleges unfair competition on the basis that Defendants have misused the similarity between the products to misrepresent to consumers that they were the original inventors of the product rather than Plaintiff. As a result, Plaintiff contends that Defendants have confused potential customers and damaged Plaintiff's reputation.

Unless otherwise indicated, the following facts are undisputed:

Plaintiff owns the '389 Patent, which was invented by Brian McClintock ("McClintock") and Michael Moffa ("Moffa"). The title in the patent gives Plaintiff the right to sue for patent infringement. Plaintiff's '389 Patent covers

¹ On October 29, 2002 the Court ordered that the name of defendant Kustom Fit Hi-Tech Seating Products, Inc. be changed to Hi-Tech Seating Products, Inc.

and is directed at folding stowaway seats used in mass-transit. Plaintiff markets its "Feather Weight," "BV Foldaway Seat" for installation in buses that require the space occupied by the seat to be used for other purposes when the seat is not occupied, i.e, for one wheelchair-bound passenger.

Both Plaintiff and Defendants are in competition in the manufacture and sale of seating products. Plaintiff seeks an injunction and other relief against Defendants growing out of Defendants' manufacture, use, or sale of the seating products that allegedly infringe Plaintiff's '389 Patent. Defendants actively use, sale and offer stowable seats in this district and also in foreign counties, which allegedly infringe the '389 Patent.

McClintock and Moffa believed that their technology in removing the legs of stowable seats was innovative, and that they devised an elegant kinematic solution to move the seat from its horizontal deployed position to a vertical stowed position and back again to a deployed position. In the section of the '389 Patent marked "BACKGROUND OF THE INVENTION,"² the patentees stated the following:

This invention relates generally to an improved fold away seat for use in a vehicle in order to provide a space for a wheelchair or for storage of various articles. The invention employs a cantilevered³

² Defendants object to the substance of the "BACKGROUND OF THE INVENTION" section as "merely language from the patent and is not evidence." (Defendants Statement of Genuine Issues ("Defendants SGIs") ¶6).

³ The American Heritage® Dictionary of the English Language defines a cantilever as:

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seatbase which pivots about one end from a horizontally deployed position to a vertically stowed position where a diagonal truss supports the seatbase when in the horizontally deployed position. The seatbase is provided with a seatback which has a lockable unfolded position as well as a lockable folded position flat against the seatbase where the range of motion of the seatback is perpendicular to the range of motion to the seatbase. The fold away seat is stowed by folding the seatback flat against the seatbase, unlocking the seatbase from its horizontally deployed position and raising the seatbase to its vertically stowed position where it is locked into place. The wheelchair or other article may be placed in the space vacated by the stowed seat.

According to Plaintiff, the inventors set forth the prior art by plainly explaining the disadvantage of seats known to them which included a seat with a leg known extending into the aisle from the seat:

At the present, the seats known are those which include a seatbase which has a support leg extending from the aisle end of the seatbase. Typically, the aisle leg is fastened to the floor when the seat is down or tucked away when the seat is stowed away. While the known foldaway seats having a support leg can be folded up to provide

[(1)] A projecting structure, such as a beam, that is supported at one end and carries a load at the other end or along its length[; (2)] A member, such as a beam, that projects beyond a fulcrum and is supported by a balancing member or a downward force behind the fulcrum[; or (3)] a bracket or block supporting a balcony or cornice.

(The American Heritage® Dictionary of the English Language, (4th ed. 2000)).

for a user or storage, this does not disclose, teach or suggest a cantilevered seat which avoids the attendant difficulties arising from the use of the aisle leg on the seatbase which may interfere with an operator and requires additional steps for stowing.

Plaintiff alleges that the prior art described in the above statement together with the pictures of the C.E White '141 Patent clearly show that even when the prior art is reviewed, it does not teach or suggest a combination of elements as set forth in the claims of the '389 Patent, and therefore the claims in the '389 Patent are nonobvious.

Plaintiff states that the stowable seat illustrated in the '389 Patent is a legless design, which is cheaper to install and maintain, can be easily and quickly deployed and stowed, does not require legs that have to be fastened and unfastened, and affords more vehicle space when the seat is stowed.

Plaintiff offers the language of Claim 1, a representative claim, to define the invention as follows:

1. A stowable seat for mounting to support member of a vehicle wherein a space may be selectively, provided positioning an article adjacent to the stowable seat, when stowed comprising: a frame attached to a support member; a cantilevered seatbase having a free end; a pivotable end including pivot mounted thereto for rotatably associating said pivotable end with said frame and for providing said seatbase with a range of motion extending from a horizontally deployed position to a vertically stowed position, a support member for supporting said deployed position including a movable end slidably mounted to said

seatbase and a fixed end journaled with said frame, and a first lock near said free end for releasably locking said movable end to maintain said seatbase in said deployed position; and a seatback having a pivot for rotatably associating said seatback with said seatbase and for providing said seatback with a range of motion extending from an unfolded position to a folded position, said range of motion of said seatback being perpendicular to said range of motion of said seatbase said seatback in said unfolded position adapted to be at a predetermined angle with respect to said seatbase in said deployed position adapted to be adjacent said seatbase for stowing to provide the space for the article.

The closest prior art to the '389 Patent is the C.E. White Co. ("C.E. White") device, which was eventually issued as U.S. Patent 5,489,141 ("141 Patent").⁴ The '141 Patent was issued immediately before the '389 Patent and was therefore not available to Plaintiff until after publication. According to Plaintiff, the C.E. White device was disclosed on the basis of the inventors describing the device and its disadvantages to the PTO in the language set forth above.

Defendants had access to Plaintiff's stowaway seat. Defendants had Plaintiff's device at their facilities as early as 2000, and Defendants would also have had ample access to Plaintiff's device in the market place for at least five years, as well as at industry trade shows where both Plaintiff and Defendant American Seating exhibited their

⁴ C.E. White is the assignee of the '141 Patent, which was invented by Donald Strausbaugh, Scott K. Hiler, Robert L. Knapp, and Kenneth A. Fox. The date of the patent is February 6, 1996.

products. Defendants displayed a large "patent pending" sign to the public at the time they introduced the accused seat.⁶

After Plaintiff filed this suit against Defendants, Defendants filed a counterclaim against Plaintiff that the '389 Patent was invalid and not infringed. Plaintiff alleges that from the time of the filing of this suit until the present, Plaintiff has consistently maintained and represented to the Court that the structure of the accused device is equivalent to the claim statue of Plaintiff's '389 Patent, and that the elements of the '389 Patent are literally infringed by the accused device, except for one claim element. This one claim element is found in a fourth link, which is attached to the third link of a four bar mechanism. According to Plaintiff, the accused device's fourth link is equivalent to the fourth link, i.e., the slider crank, of the '389 Patent. Plaintiff alleges that these fourth links in both devices operate in such a way that there is a one-to-one correspondence of the elements, and with the exception of such links, all the elements of the accused device literally correspond to all the claims in the '389 Patent.

⁶ The parties agree that the following is an accurate description of the accused device. Similar to Plaintiff's seat, Defendants' device is a fold up seat that can be used in mass transit: Defendants' device utilizes a brace connected to an intermediate link. Due to this intermediate link, the upper end of the brace does not contact with the seat base to support it. As the seat of the device pivots upward to the stowed position, the diagonal brace swings away from the bottom of the seat. The diagonal brace is subjected to forces that apply bending movements to the brace, whereas the '389 Patent is subjected only to compressive forces.

II. JUDICIAL STANDARD

A. Summary Judgement Standard

Under the Federal Rules of Civil Procedure, summary judgment is proper only where "the pleadings, depositions, answers to interrogatories, and admissions on file, together with affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). Upon such a showing, the Court may grant summary judgment "upon all or any part thereof." Fed. R. Civ. P. 56(a), (b).

To prevail on a summary judgment motion, the moving party must show there are no triable issues of fact as to matters upon which it has the burden of proof at trial. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). On issues where the moving party does not have the burden of proof at trial, the moving party is required only to show that there is an absence of evidence to support the non-moving party's case. See *Celotex Corp. v. Catrett*, 477 U.S. at 326.

To defeat a summary judgment, the non-moving party may not merely rely on its pleadings or on conclusory statements. Fed. R. Civ. P. 56(e). Nor may the non-moving party merely attack or discredit the moving party's evidence. *National Union Fire Ins. Co. v. Argonaut Ins. Co.*, 701 F.2d 95, 97 (9th Cir. 1983). The non-moving party must affirmatively present specific admissible evidence sufficient to create a genuine issue of material fact for trial. See *Celotex Corp. v. Catrett*, 477 U.S. at 324.

B. Summary Judgment In Patent Infringement Cases

"Summary judgment is as appropriate in a patent case as it is in any other." *Spectra Corp. v. Lutz*, 839 F.2d 1579, 1581 n.6 (Fed. Cir. 2000). The analysis to determine whether infringement occurred involves two steps. First, when the meaning or scope of a patent claim is in dispute, the Court construes the claim as a matter of law. See *Bell Atlantic Network Servs. v. Covad Comm. Group*, 262 F.3d 1258, 1267 (Fed. Cir. 2001); see also *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed. Cir. 1995). Second, the Court compares the properly construed claims to the accused product. *Bell Atlantic Network Servs.*, 262 F.3d at 1267. To meet its burden of proving infringement of a patent claim, a party must establish that the accused product satisfies each and every limitation of that claim, either literally or under the doctrine of equivalents. See *Zelinski v. Brunswick Corp.*, 185 F.3d 1311, 1316 (Fed. Cir. 1999). If an accused product does not satisfy one or more limitations of an independent claim, it necessarily does not satisfy one or more limitations of the related dependent claims. Therefore, a finding of non-infringement of an independent claim results in a finding that the related dependent claims are also not infringed. See *Jeneric/Pentron v. Dillon Co.*, 105 F.3d 1377, 1383 (Fed. Cir. 2000).

1. Claim Construction

An infringement analysis involves a two-step inquiry: (1) determining the meaning and scope of the patent claims asserted to be infringed; and (2) comparing the properly construed claims to the accused device. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).

a. *Principles of claim construction*

Claim construction of a patent, including terms of art within claims, is exclusively within the province of the court, not the jury. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388-89 (1996).

It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history. See *Markman*, 52 F.3d at 979, 34 U.S.P.Q.2d at 1329. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996).

The first step is to look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention. *Id.* Second, it is necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. *Id.* The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. *Id.* "Claims must be read in view of the specification, of which they are a part." *Id.* (citing *Markman*, 52 F.3d at 979). The specification is always highly relevant to the claim construction analysis, and usually, it is dispositive; it is the single best guide to the meaning of a disputed term. *Id.* The drawings or figures of the patent are considered with the specification in interpreting claim language. *Wright Medical Tech., Inc. v. Osteonics Corp.*, 122 F.3d 1440, 1443 (Fed. Cir. 1997). Third, the court may also consider the prosecution

history of the patent, if in evidence. *Vitronics Corp.*, 90 F.3d at 1582.

If an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term, it is improper to rely on extrinsic evidence. *Id.* at 1583. Extrinsic evidence is that evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles. *Id.* at 1584. Extrinsic evidence in general, and expert testimony in particular, may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language. *Id.*

b. Literal Infringement

In order to find literal infringement, the accused device must contain every limitation of the asserted claim. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535 (Fed. Cir. 1991). "It is . . . well settled that each element of a claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of every element . . . in the accused device." *Lemelson v. United States*, 752 F.2d 1538, 1151 (Fed. Cir. 1985).

c. Doctrine of Equivalence

If an accused product does not fall within the literal language of a properly construed claim, infringement may be shown nevertheless if an accused device "performs substantially the same function in substantially the same way to achieve substantially the same result." *Graver Tank & Mfg. Co. v. Linde Air Prods Co.*, 339 U.S. 605, 608 (1950). All of the claim elements or functions must be

present in the accused device, literally or by an equivalent function or element. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S.Ct. 1040, 1054, 137 L.Ed.2d 146 (1997). However, a one-to-one correspondence between components of the accused device and the claimed invention is not necessary:

One-to-one correspondence of components is not required and elements or steps may be combined without ipso facto loss of equivalency. In other words, two physical components of an accused device may be viewed in combination to serve as an equivalent of one element of a claimed invention, as long as no claim is thereby wholly vitiated.

Ethicon Endo-Surgery Inc. v. United States, 149 F.3d 1309, 1320 (Fed. Cir. 1998) (citations omitted).

A determination of equivalence under the doctrine of equivalents is a question of fact. *Lemelson*, 752 F.2d at 1550. However, the Supreme Court has made it clear that "[w]here the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment." *Warner-Jenkinson*, 117 S.Ct. at 1053 n.8. Likewise, where there is no genuine issue of material fact that claim elements are equivalent, summary adjudication or summary judgment is proper.

III. DISCUSSION

A. Plaintiff Is Entitled To Summary Adjudication

Plaintiff requests that this Court find, as a matter of law, that (1) Plaintiff's '389 Patent is valid; and (2) Defendants

infringe the '389 Patent under the doctrine of equivalents. For the reasons discussed below, this Court grants Plaintiff's Motion for Summary Adjudication.

1. Plaintiff's '389 Patent Is Valid

Defendants contend that Freedman's Patent is invalid because it is obvious and consists of ideas that have long been in the public domain. However, for the reasons discussed below, this Court disagrees.

It is well established that "[a] patent is presumed valid, and the burden of establishing invalidity as to any claim of a patent rests upon the party asserting such invalidity." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662 (Fed. Cir. 2000) (citing 35 U.S.C. §282). Therefore, Defendants have the burden of proving the '389 Patent invalid. In attempting to prove invalidity, Defendants correctly point out that a patent may be invalidated is by a showing of obviousness. A patent is "obvious," i.e., indistinguishable, "if the differences between it and the prior art 'are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.'" *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662 (Fed. Cir. 2000) (citing 35 U.S.C. §103(a)). "In order to determine obviousness as a legal matter, four factual inquiries must be made concerning: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the claimed invention and the prior art; and 4) secondary considerations of nonobviousness, which in case law is often said to include commercial success, long-felt but unresolved need, failure of others, copying, and unexpected results." *Id.* (citing *Graham v. John Deere Co.*, 383

U.S. 1, 17-18 (1966); *Miles Labs. Inc. v. Shandon, Inc.*, 997 F.2d 870, 877 (Fed. Cir. 1993).

In analyzing the above factors as addressed by the parties, this Court finds that Plaintiff's '389 Patent is valid. Defendants have not provided evidence that demonstrates the '389 Patent is obvious and indistinguishable from prior art.

The record reflects that at the time of filing the application for the '389 Patent, no prior art existed which embodied Plaintiff's invention to prohibit its patentability. It is undisputed that the closest patent to Plaintiff's '389 Patent was C.E. White's '141 Patent, which was issued right before the '389 Patent.⁶ Although the '141 Patent was the most similar to the '389 Patent, the '141 Patent does not teach folding chairs of cantilever design in mass transit settings. The C.E. White device is considerably different from Plaintiff's device in that the C.E. White device includes a seatbase which has a support leg extending from the aisle end of the seatbase and could not be folded without extra steps of folding the support legs in. ((Declaration of Irvin C. Alter in Support of Plaintiff's Motion for Summary Judgment ("Alter Decl."), used to compare Appendix R – Exhibit 18 (the '389 Patent) with Appendix T – Exh. 20 (the C.E. White '141 Patent)).

In addition, an examination of the various other patents offered by Defendants, which unlike the C.E. White Patent encompass cantilever seats, do not consist of

⁶ As required by U.S. Patent Office practice, until the patent application for the '141 patent is issued, the '141 Patent remained confidential, and was not available to Plaintiff during the prosecution of the '389 Patent.

prior art that would invalidate Plaintiff's patent. Moreover, Defendants do not present information that clearly and convincingly demonstrates obviousness of the '389 Patent resulting from the existence of "a reason, suggestion, or motivation in the prior art or elsewhere that would lead one of ordinary skill in the art to combine the references[,] i.e., combine the C.E. White Patent with any patents covering preexisting patented cantilever seat devices. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) ("[T]he Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and to combine then to render the claimed invention obvious."); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law make clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") Defendants do not show the legal obviousness of combining or modifying alleged prior art dealing with cantilever seats with the C.E. White '141 Patent to teach Plaintiff's device without steps of invention. Furthermore, Defendants do not designate evidence to support their contentions that the scope and content of the prior art is such that Plaintiff's '389 Patent is invalid.

Moreover, although Defendants would have this Court believe otherwise, it appears that the United States Patent and Trademark Office ("PTO") was adequately informed of the relevant prior art because such art was sufficiently presented in the "BACKGROUND OF THE INVENTION" section of Plaintiff's '389 Patent application. (Alter Decl. ¶ 15). Such a disclosure cuts against Defendants'

argument that Plaintiff failed to offer material information, or submitted false information, with an intent to deceive the PTO. Moreover, Defendants offer no persuasive evidence of any attempt by Defendants to engage in inequitable conduct.⁷

In sum, Defendants fail to meet their burden of establishing invalidity. Moreover, Defendants have not proven that the differences between the claimed subject matter and prior art are so indistinguishable "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. §103 (Fed. Cir. 2000). In light of Defendants failure to prove invalidity through obviousness or otherwise, this Court concludes that Plaintiff's '389 Patent is valid.

⁷ On July 21, 2003, this Court granted in part and denied in part Defendants Motion for Leave to Amend Answer and Counterclaim ("Motion for Leave"). Defendants' Motion for Leave was granted only to permit Defendants to amend their Answer to add the defense of patent invalidity. Although in ruling on Defendants' Motion for Leave, this Court stated that the C.E. White device and Plaintiff's device had "extensive similarities," this did not mean that the C.E. White device foreclosed the patentability of Plaintiff's device. Moreover, although the Court also stated that Plaintiff had a possible "deceptive intent" in not "direct[ly] mention[ing]" ... the C.E. White structure," in its patent, further facts have proven no such deceptive intent.

2. Claim Construction of the '389 Patent⁸

As discussed above, a determination of infringement requires a two-step analysis: "First, the court determines the scope and meaning of the patent claims asserted. . . . [Second,] the properly construed claims are compared to the allegedly infringing device." *Cybor Corp. V. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc) (citations omitted). "Step one, claim construction, is an issue of law." *Id.* (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996)). "Step two, comparison of the claim to the accused device, requires a determination that every claim limitation or its equivalent be found in the accused device." *Id.* (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997)).

While the patent's scope is not limited to its literal terms, it is the patent owner that must demonstrate the presence of every element or its substantial equivalent. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997). The patent owner also bears the burden of proving infringement by a preponderance of the evidence. *Mannesmann DeMag Corp. v. Engineered Metal Prods., Co., Inc.*, 793 F.2d 1279, 1282 (Fed. Cir. 1986).

⁸ The facts of this case indicate wholesale copying of certain aspects of Plaintiff device. Specifically, Defendants do not dispute that, after having access to Plaintiff's stowaway seat in the marketplace for at least five years, they created a device with identical measurements to Plaintiff's device with respect to (1) floor to lower truss pivot dimension, (2) lower truss pivot to upper wall mount pivot; (3) upper wall mount pivot to deployed truss hook; (4) truss length center to center; and (5) length of slider engagement.

Plaintiff's '389 Patent consists of 19 claims.⁹ According to the parties, there is no real dispute over the literal meaning of the claims. All the claims in the '389 Patent call for the support member to have a movable end that is slidably mounted to the seatbase.¹⁰ However, the dispute arises as to whether the '389 Patent's support member and movable end is equivalent to that found in the accused device. According to Plaintiff, the accused device's support member has a movable end that is associated with the seatbase in an equivalent manner as the '389 Patent. Plaintiff argues that the sole difference between the claims in the '389 Patent and the accused device is that the accused device has a support member with a movable end that is *rotatably mounted to a fourth link* on the underside of the seatbase whereas the '389 Patent's claims cover a support member with a movable end that is *slidably and rotatably mounted within a runner track* on the underside of the seatbase. Because Plaintiff argues that a claim is not literally infringed, but is so close as to be practically identical, this Court examines such a claim under the Doctrine of Equivalents.

Doctrine Of Equivalents

The issue under the Doctrine of Equivalents is whether Plaintiff's slider crank is equivalent to the fourth

⁹ Plaintiff prepared a claim chart to demonstrate that every that every [sic] element of the claims is literally or equivalently responded to by the accused device. (Alter Decl., Appendix P).

¹⁰ Specifically, the parties agree that the asserted claims include a sliding mechanism which is comprised of a "support member for supporting said seatbase in said deployed position[.]" where the support member "includ[es] a movable end slidably mounted to said seatbase and a fixed end journalled with said frame."

link of Defendants' device. Defendants maintain that it is not equivalent, arguing that the fourth-link of Defendants' seat is an intermediate one, which creates a completely different support structure when the stowaway seat is deployed. However, for the reasons discussed below, this Court disagrees.

If an accused product does not fall within the literal language of a properly construed claim, infringement may be shown nevertheless if an accused device "performs substantially the same function in substantially the same way to achieve substantially the same result." *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950).¹¹ The United States Supreme Court recently affirmed the viability of the Doctrine of Equivalents in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, whereby the Court acknowledged that although the

¹¹ The Court in *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, explained the Doctrine of Equivalents in the following manner:

[C]ourts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for – indeed encourage – the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form.

Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 607 (1950).

Doctrine results in uncertainty regarding the true scope of the patent, that "this uncertainty [i]s the price of ensuring the appropriate incentives for innovation, and it has affirmed the Doctrine over dissents that urged a more certain rule." 122 S.Ct.1831, 1835, 1838 (2002).

However, "[b]ased on the fundamental principle that no one deserves an exclusive right to technology already in the public domain, th[e] court has consistently limited the doctrine of equivalents. . . ." *Marquip, Inc. v. Fosber Am., Inc.*, 198 F.3d 1363, 1367 (Fed. Cir. 1999) (citing *Wilson Sporting Goods v. David Geoffrey & Assoc.*, 904 F.2d 677, 683 (Fed Cir. 1990)). "[T]he reason for the limitation is to prevent the patentee from obtaining under the doctrine of equivalents coverage it could not have obtained from the Patent and Trademark Office (PTO) by literal claims. Because prior art limits the exclusive right available to an inventor, it also limits the range of permissible equivalents of a claim." *Id.* (citing *Wilson Sporting Goods v. David Geoffrey & Assoc.*, 904 F.2d 677, 684 (Fed Cir. 1990)).

Defendants argue that Plaintiff has not presented evidence to demonstrate Defendant's infringement under the Doctrine of Equivalents.¹² Specifically, Defendants contend that Plaintiff's analysis of equivalents was too narrowly focused on a single type of force placed on the '389 seatbase when deployed. According to Defendants,

¹² "Defendants also contend that Plaintiff's intent in securing the '389 Patent was to "ensnare prior art." *Marquip, Inc. v. Fosber Am., Inc.*, 198 F.3d 1363, 1367 (Fed. Cir. 1999). However, because the Court has already determined that the offered prior art does not invalidate Plaintiff's '389 Patent, no further discussion is necessary. Indeed, the record does not reflect the existence of prior art that teaches individually, or in combination, all the elements of the '389 Patent.

Plaintiff's alleged concentration on kinematics¹³ (with respect to when Plaintiff's device was being deployed), and failure to take into account factors such as statics¹⁴ (with respect to when Plaintiff's device was deployed), is fatal to Plaintiff's claim of infringement.

For support, Defendants heavily rely on the Federal Circuit case, *Forest Labs., Inc., v. Ony Inc.* ("Forest Labs"), which involved patents relating to lung surfactant composition for treating respiratory distress syndrome in premature babies. In determining that the patents were not literally infringed or infringed under doctrine of equivalents, the *Forest Labs* Court held, *inter alia* that the plaintiffs failed to offer evidence that the accused product possessed the same or an equivalent percentage of water as claimed under the plaintiffs' patents.

In the present case, Plaintiff does not explicitly claim any particular method of force used in the '389 patent with respect to the seatbase or support member when the seat is deployed or while being deployed. Defendants' arguments focusing on the differences in the use of force on the seatbase, whether kinematic or otherwise, is marginally, if at all relevant. Indeed, there is no genuine issue of material fact that the accused device functions in a manner that is so similar to the '389 patent as to achieve the

¹³ Kinematics is defined as "[t]he branch of mechanics that studies the motion of a body or a system of bodies without consideration given to its mass or the forces acting on it." (The American Heritage® Dictionary of the English Language, (4th ed. 2000)).

¹⁴ Statics is defined as "[t]hat branch of mechanics which treats of the equilibrium of forces, or relates to bodies as held at rest by the forces acting on them; - distinguished from dynamics." (Webster's Revised Unabridged Dictionary (4th ed. 1998)).

practically identical result. Although there may be a difference in the distribution of forces exerted when deploying Plaintiff's device, as opposed to Defendants' device, i.e., compression versus bending forces, respectively, such differences are too insignificant to find noninfringement. The difference in any forces exerted when the seats are deployed are also so insubstantial as to find noninfringement. Therefore, because the elements of Plaintiff's slider-crank and Defendants' fourth link perform substantially the same function in substantially the same manner to achieve substantially the same result, this Court concludes that Defendants have infringed on Plaintiff's patent under the Doctrine of Equivalents.¹⁵

Accordingly, because the alleged differences between the accused product and the claimed element are insubstantial to one of ordinary skill in the art, the Doctrine of Equivalents requires a finding of infringement. *Sage Prods. Inc. v. Devon Indus., Inc.*, 126 F.3d 1420 (Fed. Cir. 1997) ("The doctrine of equivalents prevents an accused infringer from avoiding infringement by changing only minor or insubstantial details of a claimed invention while retaining their essential functionality"). As such, summary

¹⁵ Defendants also attempt to differentiate their Horizon seat by arguing that the "manner of travel" during folding is substantially different in the competing devices. According to Defendants, the motion of the Freedman chair is controlled strictly by the length of the track in the seatbase while the Horizon Stowaway Seat's travel is controlled by the interaction between the brace and the intermediate link. However, Defendants attempt to distinguish its device from the '389 Patent does not escape a finding that the claim elements are equivalent as discussed. Moreover, contrary to Defendants' belief, it makes little difference that the two mechanisms in the competing devices cannot be interchanged, or that there is an alleged lack of frictional forces or supposed ease maintenance in the accused device.

adjudication in favor of Plaintiff with respect to its cause of action for patent infringement is warranted.

B. Defendants Are Entitled To Partial Summary Judgment With Respect To Plaintiff's Claim of Unfair Competition Under The Lanham Act

Defendants move for summary adjudication on two grounds. First, Defendants argue that their Horizon Stowaway Seat does not infringe Plaintiff's '389 Patent. Second, Defendants contend that Plaintiff cannot prove has [sic] claim of unfair competition under the Lanham Act. As for Defendants' first ground, summary adjudication is not warranted in light of this Court's finding, as a matter of law, that Defendants have infringed the '389 Patent. However, as for Defendants' second ground, i.e., Plaintiff's Lanham Act claim, Defendants are entitled to summary adjunction for the reasons discussed below.

Plaintiff alleges in its Complaint that Defendants' Horizon Stowaway Seat duplicates the functions and appearance of Plaintiff's patented seat, and thereby creates a likelihood of confusion. Specifically, Plaintiff alleges that Defendants

[H]a[ve] not only made a copycat version of FREEDMAN's patented seating product by nearly duplicating all of its functions, but also by creating linkages of the same type found in FREEDMAN's patented device that even correspond in dimention so that the accused device differs only in minor, insignificant details. The duplicated function as well as the appearance not only have a likelihood of confusion, but also

amount to "copycat" duplication of FREEDMAN's patented seating product.

(Complaint ¶ 19). However, Plaintiff neither supports its allegations with sufficient evidence nor offers binding case to support its position. Rather, Plaintiff makes conclusory statements and bald assertions. Plaintiff's failure to present competent evidence combined with the analysis below, requires summary adjudication in favor of Defendants with respect to Plaintiff's Lanham Act claim.

1. The features of Plaintiff's device are de jure functional and therefore cannot support a finding of a likelihood of confusion under the Lanham Act

Plaintiff carries the burden of showing that the features allegedly copied are not functional. *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 27 (2001). To meet this burden, Plaintiff simply states, without supporting evidence, that its device is "quite distinctive" as it appears to be "floating in the air[,] and therefore cannot be deemed functional. However, such assertions cannot be said to meet Plaintiff's burden.

Moreover, the '389 Patent application establishes the function of the linkages in the patent is to support the seat in the deployed position and to fold when the seat is stowed. It appears that every part of the linkage system is specifically designed to provide the function of a folding cantilever seat. That is, the several parts of the linkage function mechanically to support the seat when deployed and stowed. There is no proof that any linkage is arbitrary or has developed secondary meaning as to designate the source of Plaintiff [sic] device.

In light of the foregoing, the linkages in Plaintiff's device are functional and not arbitrary. As such, Defendants use of similar linkages do not create a likelihood of confusion to support a claim under the Lanham Act.

2. The overall appearance of Plaintiff's device is not actionable under the Lanham Act

Although not expressly articulated, it appears that Plaintiff attempts to hold Defendants liable under the Lanham Act for trade dress infringement for copying the "appearance" of Plaintiff's device, thereby creating a likelihood of confusion. However, Plaintiff's claim is meritless.

Trade dress refers generally to the total image, design, and overall appearance of a product and "may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992)); see also *Int'l Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 822 (9th Cir. 1993). A plaintiff seeking to recover for infringement of a trade dress under the Lanham Act must prove its claimed dress is (1) nonfunctional, (2) serves a source-identifying role either because it is inherently distinctive or has acquired secondary meaning; and (3) there [sic] a likelihood the defendant's product will create consumer confusion. See *Disc Golf Ass'n v. Champion Discs, Inc.*, 158 F.3d 1002, 1005 (9th Cir. 1998); *California Scents v. Surco Products, Inc.*, 28 Fed. Appx. 659, 660 (9th Cir. 2002).

In the present case, Plaintiff does not offer any evidence of trade dress infringement. Instead, Plaintiff merely argues that Defendants conduct in allegedly

copying Plaintiff's device was willful and with malice. However, such accusations do not support any recognizable claim under the Lanham Act.

Without any proven viable claim of unfair competition under the Lanham Act, this Court must grant summary adjudication in favor of Defendants with respect to Plaintiff's Lanham Act cause of action.

IV. CONCLUSION

Accordingly, this Court:

- (1) **GRANTS** Plaintiff's Motion for Summary Adjudication; and
- (2) **GRANTS in part and DENIES in part** Defendants' Motion for Summary Adjudication. Defendants' Motion is granted with respect to Plaintiff's Unfair Competition claim under the Lanham Act and denied on all other grounds.

The parties are to bear their own costs.

IT IS SO ORDERED.

Initials of Deputy Clerk: /s/ [Illegible]

AMENDED

P-SEND

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CIVIL MINUTES – GENERAL**

Case No. CV 02-5347 RGK (RNBx) Date: November 7, 2003

TITLE: *FREEDMAN SEATING CO. v. AMERICAN SEATING CO., et al.*

**PRESENT: THE HONORABLE R. GARY KLAUSNER,
U.S. DISTRICT JUDGE**

Sharon L. Williams
Courtroom Clerk

Not Reported
Court Reporter

**ATTORNEY FOR
PLAINTIFF:**

**ATTORNEY FOR
DEFENDANT:**

Not Present

Not Present

**PROCEEDINGS: (IN CHAMBERS) ORDER GRANT-
ING IN PART AND DENYING IN
PART DEFENDANTS' MOTION
FOR RECONSIDERATION**

This action is brought by Plaintiff Freedman Seating Co. ("Plaintiff" or "Freedman") against Defendants American Seating Company ("American Seating") and Kustom Fit Hi-Tech Seating Products, Inc.¹ ("Hi-Tech Seating") (collectively, "Defendants") for:

- (1) Patent Infringement; and
- (2) Unfair Competition under the Lanham Act.

¹ On October 29, 2002 the Court ordered that the name of defendant Kustom Fit Hi-Tech Seating Products, Inc. be changed to Hi-Tech Seating Products, Inc.

Plaintiff is the owner of U.S. Patent No. 5,492,389 ("389 Patent") for a Stowable Seat. Plaintiff alleges that Defendants contracted to manufacture seating products that infringe on Plaintiff's patent.

On October 23, 2003, the Court granted Plaintiff's Motion for Summary Adjudication, finding that Plaintiff was entitled to summary judgment with respect to its claim for patent infringement ("October 23, 2003 Order"). In response to this Court's October 23, 2003 Order, Defendants filed a Motion for Reconsideration on November 3, 2003, arguing that the Court improperly granted summary judgment ("Defendants' Motion"). Defendants' Motion is the subject of this Order.

According to Defendants, the Court inappropriately granted summary judgment for the following reasons: (1) The issue of patent unforceability was never addressed by the parties and Defendants were never given an opportunity to be heard; (2) The Court applied the wrong standard on the issue of invalidity and failed to draw all factual inferences in Defendants' favor; and (3) The Court failed to consider factual disputes, or erred by resolving them, in determining the issue of infringement.

The standard for reconsideration where the Court has granted summary judgment is well settled. Reconsideration of a grant of a motion for summary judgment can be made under Federal Rule of Civil Procedure 59(e). Rule 59(e) allows a party to bring a motion to alter or amend a judgment. *See* Fed. R. Civ. P. 59(e). Reconsideration is appropriate if the district court "(1) is presented with newly discovered evidence, (2) committed clear error or the initial decision was manifestly unjust, or (3) if there is an intervening change in controlling law." *School Dist. No. 1J*,

Multnomah County v. AcandS, Inc., 5 F.3d 1255, 1262 (9th Cir. 1993).

Under Local Rule 7-18, this Court is empowered to reconsider its own decisions on prior motions. Local Rule 7-18 specifically provides that:

A motion for reconsideration of the decision on any motion may be made only on the grounds of (a) a material difference in fact or law from that presented to the Court before such decision that in the exercise of reasonable diligence could not have been known to the party moving for reconsideration at the time of such decision, or (b) the emergence of new material facts or a change of law occurring after the time of such decision, or (c) a manifest showing of a failure to consider material facts presented to the Court before such decision. No motion for reconsideration shall in any manner repeat any oral or written argument made in support of or in opposition to the original motion.

Local Rule 7-18.

Upon review of Defendants' Motion, it is apparent that Defendants believe that this Court committed "clear error," came to a "manifestly unjust" decision, (Fed. R. Civ. P. 59(e)), or "fail[ed] to consider material facts presented to the Court" before making its decision." (Local Rule 7-18). However, a review of the record, arguments and case law presented by the parties does not indicate a manifest showing of clear error in the Court's ruling.

Defendants' first ground for reconsideration relates to whether the Court inappropriately disposed of Defendants' newly added defense of inequitable conduct. According to Defendants, the issue of inequitable conduct was not

before the Court, and thus, could not be adjudicated. To support its contention, Defendants cite *Fin Control Systems Pty, Ltd. v. OAM, Inc.*, 265 F.3d 1311 (Fed. Cir. 2001), whereby the Federal Circuit held that a district court improperly granted sua sponte summary judgment in favor of the alleged infringer on its counterclaims of patent invalidity and unenforceability.

However, Defendants reliance on *Fin Controls* is misguided because the present matter is clearly distinguishable. Indeed, whereas invalidity was not the subject of any motion before the district court in *Fin Controls*, such an issue was before this Court.² Moreover, as for the issue of patent unenforceability resulting from Plaintiff's alleged inequitable conduct, it is apparent to this Court that Defendants' contentions would be based on the same arguments for finding invalidity, which have already been rejected.

On September 4, 2003, this Court permitted Defendants leave to amend their answer only to assert a defense of inequitable conduct during the prosecution of the patent application. According to Defendants, Plaintiff purposely failed to disclose prior art to the patent examiner which was crucial to the determination of patentability. As a result, Defendant argued that a proper inspection of the prior art was not conducted by the patent examiner in the

² Defendants also cite *Pandrol USA, LP v. Airboss Railway Productions, Inc.*, 320 F.3d 1354 (Fed. Cir. 2003) for support. However, the *Pandrol* case basically stands for the proposition that "the issue of invalidity is a separate issue from infringement, and an alleged infringer's failure to raise it in opposition to a motion for summary judgment of infringement is not a waiver." In the present matter, the issue of patent invalidity was raised by the parties and thoroughly [sic] discussed by the Court in the October 23, 2003 Order.

course of granting Plaintiff's patent. Because the arguments Defendants' relied on for patent invalidity were the same meritless arguments Defendants used to amend their Answer to add the defense of inequitable conduct, the Court finds little reason to permit Defendants to proceed to trial on such a defense. Moreover, this Court also recognizes that absent from Defendants' present motion is any indication that Defendants' inequitable conduct defense would be viable, or that arguments supporting inequitable conduct would be different than Defendants' arguments for invalidity. At no time after this Court granted Defendants leave to amend its Answer to add the inequitable conduct defense, and not even at this juncture, do Defendants offer evidence of Plaintiff's inequitable conduct. Rather, Defendants simply contend that a jury trial is required on this issue.

As permitted by Federal Rules of Civil Procedure and the Local Rules of this Court, Defendants have the opportunity in its Motion for Reconsideration to present argument or newly discovered evidence to demonstrate why the Court must rethink its previous ruling. However, for some reason, Defendants have chosen not to present such evidence, especially not on the issue of inequitable conduct. Although there is little cause to revive Defendants' inequitable conduct defense, this Court permits Defendants the opportunity to brief the specific issue and file it with the Court on or before November 12, 2003. Any Opposition will be due November 14, 2003, and any Reply by November 15, 2003. No brief shall exceed ten pages. Specifically, Defendants must demonstrate to this Court that a genuine issue of material fact exists as a matter of law with respect to Defendants equitable conduct defense.

Defendants second ground for reconsideration is based on Defendants' belief that the Court applied the wrong standard on the issue of invalidity and failed to draw all factual inferences in Defendants' favor. However, a review of the October 23, 2003 Order indicates that the Court properly ruled in favor of Plaintiff. Indeed, Defendants did not sufficiently show that a genuine issue of material fact remained for trial. Although Defendants would have this Court believe otherwise, Defendants' expert testimony³

³ Defendants argue that the Court erred in granting summary judgment on the issue of obviousness because the evidence demonstrated that there existed some suggestion, teaching, or motivation to combine references to create Plaintiff's invention. As such, Defendants contend that Plaintiff's patent was void for obviousness. According to the Federal Circuit, "[w]hether a claimed invention is unpatentable as obvious under § 103 is a question of law based on underlying findings of fact." *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). Although "[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact[.]" (*Gartside*, 203 F.3d at 1316), there is no law that prevents a court from granting summary judgment where, as here, there is no genuine issue of material fact. However, in disputing this Court's previous ruling, Defendants contend that the testimony of Roger Kaufman creates a triable issue. According to Defendants, Kaufman's testimony clearly demonstrates that there is some suggestion, teaching or motivation to combine references, and thus, summary judgment was improper with respect to the question of obviousness. However, this Court disagrees. Defendants' attempt to survive summary judgment by using Kaufman's mere legal conclusion that "it would be obvious for one of ordinary skill in the art to have adapted the seat shown in the C.E. White brochure to have a cantilever design" is insufficient to create a genuine issue of material fact. Although Defendants would have this Court believe otherwise, Kaufman's bare legal opinion does not carry the issue of obviousness to trial. Expert opinion testimony concluding that an invention is or is not obvious "do[es] not necessarily preclude the grant of summary judgment against the offering party because the obviousness of a design is a question for the court to resolve." *John Charles Designs, Inc. v. Queen Intern. Design, Inc.*, 940 F. Supp. 1516, 1521, (C.D. Cal. 1996).

and patents offered as prior art did not create a triable issue of fact.

Finally, Defendants third ground for reconsideration is based on Defendants' belief that the Court failed to consider factual disputes, or erred by resolving them, in determining the issue of infringement. In perusing the arguments and evidence presented by Defendants in connection with the October 23, 2003 Order, this Court did not, as Defendants suggest, make credibility determinations, weigh the evidence or decide which inference to draw from the facts. This Court did, however, find that Defendants presented insufficient evidence in which a reasonable fact finder could return a verdict for Defendants. As such, the Court's initial determinations were proper and reconsideration is inappropriate.

Moreover, contrary to Defendants' belief *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205 (Fed. Cir. 2003), does not support Defendants' argument that a triable issue exists. In *Medical Instrumentation*, the accused infringer successfully raised a genuine issue of material fact sufficient to defeat summary judgment on the issue of infringement by submitting expert testimony that was more than merely conclusory. *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1220 (Fed. Cir. 2003). Unlike the situation here, the expert in *Medical Instrumentation* linked each claim limitation of the patent in issue with disclosures in the prior art that the expert perceived taught each particular limitation, and quoted the particular portions of references that were relevant for each of the claim limitations. *Id.* at 1220. In the present case, similar evidence does not exist. Moreover, in *Medical Instrumentation*, with respect to the presence or absence of a motivation to combine references, the expert's declaration quoted from several prior art articles that expressly discussed the combination of certain elements of the invention. Again, similar evidence does not exist in the present matter. As such, *Medical Instruments* is factually distinguishable and cannot be used to not support Defendants' tenuous contentions.

Accordingly, Defendants' Motion for Reconsideration is **GRANTED IN PART** and **DENIED IN PART**. Defendants' Motion is granted only insofar as to permit Defendants the opportunity to brief the specific issue of inequitable conduct and file it with the Court on or before November 12, 2003. Any Opposition will be due November 13, 2003, and any Reply by November 14, 2003. No brief shall exceed ten pages. Specifically, Defendants must demonstrate to this Court that a genuine issue of material fact exists as a matter of law with respect to Defendants equitable conduct defense.

IT IS SO ORDERED.

MINUTES

CIVIL – GEN

Initials of Deputy Clerk: slw

P-SEND

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CIVIL MINUTES - GENERAL

CASE NO. CV 02-5347 RGK (RNBx) Date: November 17, 2003

TITLE: *FREEDMAN SEATING CO. v. AMERICAN
SEATING CO., et al.*

PRESENT: THE HONORABLE R. GARY KLAUSNER,
U.S. DISTRICT JUDGE

Sharon L. Williams
Courtroom Clerk

Not Reported
Court Reporter

ATTORNEY FOR
PLAINTIFF:

ATTORNEY FOR
DEFENDANT:

Not Present

Not Present

PROCEEDINGS: (IN CHAMBERS) DEFENDANTS' RE-
QUEST FOR AN ORDER FINDING
PLAINTIFF'S PATENT UNENFORCE-
ABLE DUE TO INEQUITABLE CON-
DUCT [Docket Entry 152]

I. INTRODUCTION

On November 7, 2003, this Court ordered Plaintiff Freeman Seating Company ("Plaintiff") and Defendants American Seating Company and Hi-Tech Seating Products, Inc. f/k/a Kustom Fit Hi-Tech Seating Products, Inc. (collectively "Defendants") to brief the issue of inequitable conduct ("November 7, 2003 Order"). The November 7, 2003 Order was issued in light of this Court's ruling on Defendants' Motion for Reconsideration, filed on October 23, 2003. Although the record does not reflect that Plaintiff has engaged in inequitable conduct, in an abundance of

caution, this Court permitted Defendants a final opportunity to brief the issue. Upon review of the evidence and the arguments presented by the parties, this Court finds that Defendants have failed to met [sic] the threshold criteria to permit a finding of inequitable conduct.

II. DISCUSSION

A. Standard

Inequitable conduct is an equitable issue to be decided by the Court and not the jury. *Life Techs., Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320, 1324 (Fed. Cir. 2000) ("[T]he determination of inequitable conduct is ultimately committed to the discretion of the district court.") Inequitable conduct must be proven by clear and convincing evidence that (1) the prior art was material; (2) the patent applicant had knowledge of that prior art and of its materiality; and (3) the failure of the applicant to disclose the art was a result of a purposeful intent to mislead the United States Patent and Trademark Office ("PTO"). *Elk Corp. of Dallas v. GAF Bldg. Materials Corp.*, 168 F.3d 28, 31 (Fed. Cir. 1999).

A determination of inequitable conduct requires a two-step analysis. *Baxter Int'l Inc. v. McGaw Inc.*, 149 F.3d 1321, 1327 (Fed. Cir. 1998). First, the Court must determine whether the information not supplied to the PTO meets the threshold level of materiality. *Id.* Second, the Court must determine whether the record demonstrates an intent on the part of the patent applicant to mislead the PTO. *Id.* The more material the information, the less evidence of purposeful intent is required in order to find the existence of inequitable conduct. *Id.* Likewise, the less material the information, the more evidence of purposeful

intent to mislead the PTO is required to find inequitable conduct. *Id.*

B. Defendants Have Failed To Present A Case For Their Defense Of Inequitable Conduct

Defendants argue that the information not supplied by Plaintiff to the PTO was highly material and that Plaintiff purposefully desired to mislead the PTO. As such, Defendants maintain that Plaintiff's patent is unenforceable due to inequitable conduct. However, for the reasons discussed below, a finding that Plaintiff's device is unenforceable due to inequitable conduct is not warranted. Although the Court finds that the information not supplied by Plaintiff was material, the Court does not find that Plaintiff intended to deceive the PTO Examiner.

1. The Information Not Supplied By Plaintiff [sic] Was Material

The Court first determines whether information not supplied to the PTO was material. There are two distinct standards for finding materiality, one which was perfected before 1992, and another which the PTO has set forth after 1992 in 37 C.F.R. § 1.56. *Dayco Prods., Inc. v. Tatal Containment, Inc.*, 329 F.3d 1358, 1363-64 (Fed. Cir. 2003). Because the Federal Circuit "ha[s] not decided whether the standard for materiality in inequitable conduct cases is governed by equitable principles or by the Patent Office's rules, *Id.* at 1364, the Court discusses the application of both standards in turn.

Under the post-1992 standard for materiality found in 37 C.F.R. § 1.56, the rule states that information is material to patentability when it is not cumulative to information

already of record, and it either (1) establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim, or (2) it refutes or is inconsistent with a position the applicant asserts before the PTO. 37 C.F.R. § 1.56(b).

As an initial matter, the Court notes that Plaintiff does not argue, and this Court does not find, that the C.E. White device is cumulative to information already of record. There is no evidence of devices similar to the C.E. White device already before the Court. Therefore, the Court must now determine (1) whether the CE [sic] White establishes, by itself, or in combination with other information, a prima facie case of unpatentability of a claim or; (2) whether the C.E. White device is inconsistent with a position Plaintiff asserted before the PTO.

Here, Defendants do not argue, and this Court does not find, that the C.E. White device establishes, by itself, or in combination, a prima facie case of unpatentability. Moreover, Defendants do not offer competent evidence to demonstrate that the C.E. White device is inconsistent with any position that Plaintiff asserted before the PTO. As such, there can be no finding of materiality under this test.

However, the same is not true when applying the pre-1992 standard for materiality. Under that test, "[a] reference is deemed material if there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent." *Baxter Int'l., Inc. v. McGaw, Inc.*, 149 F.3d 1321 (Fed. Cir. 1998) ((quoting *Halliburton Co., v. Schlumberger Tech. Corp.*, 925 F.2d 1435, 1440 (Fed. Cir. 1991) (internal quotes omitted)). "[M]ateriality is not analyzed in a

vacuum. It is not dependent on a single element viewed in isolation. Rather it is judged based upon the overall degree of similarity between the omitted reference and the claimed invention in light of the other prior art before the examiner." *Id.* at 1328.

Here, the record indicates that Plaintiff's patent was apparently structured after the C.E. White device, which, according to Plaintiff, was the most similar prior art to Plaintiff's invention. There is little doubt that a reasonable PTO Examiner would consider the C.E. White important in deciding whether to allow the application to issue as a patent. As such, the C.E. White device would be considered material under this standard.

Because the Federal Circuit has not decided which test applies, the Court, in careful consideration of the two competing standards, finds that the information not supplied to the PTO Examiner was material.

2. Under The Totality Of The Circumstances, The Evidence Does Not Demonstrate That Plaintiff Intended To Deceive The PTO By Clear And Convincing Evidence

The Court must next determine whether Plaintiff's omission clearly and convincingly portrays conduct that is sufficient to support an inference of culpable intent. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 939 (Fed. Cir. 1990). Direct proof of wrongful intent is rarely available, but wrongful intent may be inferred from clear and convincing evidence of surrounding circumstances. *LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n*, 958 F.2d 1066 (Fed. Cir. 1992). However, whether there is an "[i]ntent to deceive should be determined in

light of the realities of patent practice, and not as a matter of strict liability whatever the nature of the action before the PTO." *Id.* Even gross negligence does not itself justify an inference of an intent to deceive. *Id.*

Defendants argue that Plaintiff's intent to deceive is readily demonstrated. Defendants direct this Court's attention to the description of the C.E. White design found in Plaintiff's "Background of Invention" section of the '389 Patent, which Defendants contend is misleading and incomplete. Defendants also argue that Plaintiff intended to mislead the PTO Examiner by not explicitly naming the C.E. White device in the patent application.

The Court notes that Defendants do not attempt to demonstrate how Plaintiff's description, of the C.E. White device was misleading and incomplete. Instead, Defendants inappropriately quote this Court's September 4, 2003 Order permitting Defendants to amend their Answer to add the defense of inequitable conduct ("September 4, 2003 Order"). Although the September 4, 2003 Order did state that the facts before the Court at that time "suggest[] that Plaintiff had an intent to deceive[,]," a subsequent Order issued on October 23, 2003, based on a closer examination of the record, explicitly stated that "no such deceptive intent [existed]."

Moreover, Defendants offer no persuasive legal precedent or argument to prove that Plaintiff's failure to disclose the C.E. White device equates to inequitable conduct under the facts of this case.¹ Indeed, a failure to

¹ This Court notes that Plaintiff's reliance on *Eastman Int'l, Inc. v. McGaw, Inc.*, 149 F.3d 1321 (Fed. Cir. 1998) to prove inequitable conduct is misplaced. In particular, Defendants incorrectly imply that
(Continued on following page)

disclose alone is not enough to infer intent. *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 822 (Fed. Cir. 1992). Although Plaintiff's nondisclosure of the C.E. White device may be viewed as negligent, Defendants do not proffer evidence that Plaintiff purposely engaged in wrongful conduct. Nor does a review of the totality of the circumstances serve to demonstrate Plaintiff's wrongful intent, especially in light of the fact that there is no indication that the C.E. White device was inaccurately described to the PTO Examiner in Plaintiff's "Background of Invention" section of the '389 Patent. As such, this Court cannot conclude that Defendants have met their burden of proving, with clear and convincing evidence, an intent by Plaintiff to deceive, misled [sic] or trick the PTO Examiner issuing the '389 Patent.

III. CONCLUSION

In light of the foregoing, this Court finds that Defendants have failed to demonstrate the existence of inequitable conduct. Accordingly, Defendants Request For An

the *Baxter* Court determined that the plaintiff's patent was unenforceable for inequitable conduct simply because the plaintiff did not inform the PTO examiner of prior art.

In *Baxter*, the Federal Circuit affirmed a district court's finding of inequitable conduct where the overall configuration of the plaintiff's device was a virtual replica of undisclosed prior art in that the plaintiff's device contained each and every claim of the undisclosed prior art, except for one modification. *Baxter Int'l. Inc. v. McGaw, Inc.*, 149 F.3d 1321 (Fed. Cir. 1998). The factual scenario in *Baxter* is not representative of this case, where there is no reason to view Plaintiff's invention as essentially undisclosed prior art with a minor modification. Moreover, the present matter is distinguishable from *Baxter* because the instant case involves an accurate and adequate description of the prior art at issue in the "Background of Invention" section of the '389 Patent.

App. 71

Order Finding Plaintiff's Patent As Unenforceable Due To
Inequitable Conduct is **DENIED**.

IT IS SO ORDERED.

MINUTES
CIVIL-GEN

Initials of Deputy Clerk: slw

IN THE
Supreme Court of the United States

FREEDMAN SEATING COMPANY,

Petitioner,

v.

AMERICAN SEATING COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Was the Court of Appeals for the Federal Circuit correct in its application of the "all elements rule," which requires the doctrine of equivalents to be assessed on an element-by-element basis, to preclude a finding that the accused EZ Fold chair infringes United States Patent 5,492,389?

STATEMENT PURSUANT TO RULE 29.6

Respondent, American Seating Company, has no parent corporation and no publicly held company owns 10% or more of its stock.

INTRODUCTION

This patent infringement case presents a routine application of the all-elements rule, which was established by this Court in *Warner-Jenkinson Company, Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040 (1997). The Court of Appeals for the Federal Circuit has consistently applied this rule to preclude a finding of infringement under the doctrine of equivalents where such a finding would effectively eliminate, or “vitiate,” an element of the asserted claim. In this case, the Federal Circuit correctly applied the properly-stated rule to find non-infringement because the evidence of equivalents presented to the district court required elimination of the express limitation in the patent claims that a movable end of a diagonal truss be slidably mounted to a seat base of a folding chair.

STATEMENT OF THE CASE

The facts in this case are not those presumed in the petition. Freedman’s assertion that the Federal Circuit did not dispute the district court’s finding “that the movable end of the EZ Fold support member performed ‘substantially the same function in substantially the same manner to achieve substantially the same result’ as the movable end of Freedman’s support member” is completely wrong. After acknowledging American Seating’s argument that it had presented evidence that EZ Fold’s diagonal truss arrangement is substantially different from that claimed in the ‘389 patent (App. 14), the Federal Circuit went further to hold specifically that the “structural difference in the mounting of the moveable end to the seatbase is not a ‘subtle difference in degree’ but rather, ‘a clear, substantial difference in kind.’” (App. 24)

Freedman's assertion that interchangeability of the EZ Fold diagonal truss with the patented truss was not in dispute is also wrong. American Seating showed through the Kaufman and Reinholtz declarations that the two were very different and were, therefore, not interchangeable.

Freedman makes additional errors in its description of EZ Fold in the assertion that EZ Fold's "fourth link" is attached to the "movable end" of the diagonal truss and that the other end is attached to the seat base (Petitioner's brief at 5). That description was not supported by the record in the district court and was properly rejected by the Federal Circuit.

In the Federal Circuit analysis, one end of the fourth link is rotatably mounted to the seat base while the other end is connected to the second part of the folding diagonal truss at a "mid-joint." (App. 7, 8.) Thus, the part of the diagonal truss that Freedman asserts is the "movable end," the Federal Circuit considered to be merely a mid-joint because it never touches the seat base. There was no factual dispute over the structure of the accused EZ Fold seat, and the Federal Circuit's view of the structure in the context of the patent claims is correct in light of the unchallenged evidence.

The Federal Circuit found that the "movable end" of the diagonal truss in EZ Fold moves as the seat itself moves during folding but does not move with respect to the seat base, because it is mounted *only* for rotation at a fixed point on the seat base. Because the claims of the '389 patent expressly require the movable end to be "slidably mounted" to the seat base, the Federal Circuit held that Freedman's evidence of equivalents required vitiation of the slidably-mounted element, which violated the all-elements rule.

REASONS FOR DENYING THE PETITION

A. Petitioner's Questions Are Not Presented in This Case

The petition should be denied because the questions posed by petitioner are not factually presented by this case. Interchangeability of the overall truss mechanisms was disputed, as was whether the diagonal truss of the accused EZ Fold in fact performs the same function in the same way to achieve the same result as the claimed structure.

More relevant to the Federal Circuit's decision, however, is that the questions presented by petitioner do not specify the "elements." Not only was there conflicting evidence regarding the equivalency of the two truss mechanisms overall, but Freedman presented *no* evidence whatsoever to establish that any specific element found in EZ Fold is equivalent to the slidably-mounted movable end element specifically recited in the patent claims.

Petitioner's questions, therefore, are not presented by this case, and the petition should be denied.

B. The All-Elements Rule Applied by the Federal Circuit Does Not Conflict with Supreme Court Precedent

The petition should be denied for the additional reason that the Federal Circuit decision was based on the all-elements rule derived from *Warner-Jenkinson* and does not conflict with the decisions of this Court. Petitioner simply refuses to acknowledge the restriction the all-elements rule placed on the doctrine of equivalents.

Petitioner's attempt to use this case to mount an assault on the alleged doctrine of "foreseeability" is unavailing. The fundamental basis for the Federal Circuit finding of non-infringement was Freedman's failure to present evidence that EZ Fold had any element equivalent to the "slidably mounted" movable end expressly recited in all of the claims of the '389 patent. The Federal Circuit applied the long-standing all-elements rule, confirmed by this court in *Warner-Jenkinson*, to conclude that there was no infringement as a matter of law.

After reaching this conclusion, the Federal Circuit went further to explain that members of the public were justified in relying on the specific claim limitation of a slidably mounted movable end. Freedman's own inventors admitted that they had been aware of four-bar mechanisms in general prior to the filing of the patent application, but, even so, they presented only claims drawn narrowly to slidably mounted elements, which excluded other structures known to the inventors. Thus, the Federal Circuit did not use "foreseeability" in any sense contrary to this Court's precedent.

CONCLUSION

For the above reasons, American Seating respectfully requests that the Petition for Certiorari be denied.

Respectfully submitted,

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No. 05-648

Supreme Court, U.S.
FILED
JAN 10 2006
OFFICE OF THE CLERK

In The
Supreme Court of the United States

FREEDMAN SEATING COMPANY,

Petitioner,

vs.

AMERICAN SEATING COMPANY,

Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

Freedman's petition presents this Court with the question of whether a court can find non-equivalence between an element of an accused device and an element of a patent claim, where there is no genuine factual dispute that either (i) the claimed and accused elements are interchangeable, or (ii) the accused element performs the same function in the same way to achieve the same result as the claimed element. As Freedman demonstrated in its petition, the Federal Circuit's decision in this case improperly applied the "doctrine of equivalents," in a manner which directly conflicts with this Court's precedent, to find non-infringement as a matter of law.

Respondents' brief in opposition ("Opp.") carefully ignores the question raised by Freedman's petition, by attempting to now suggest that there are contested issues of material fact – which would have precluded the Federal Circuit's finding of noninfringement as a matter of law in the first place. In so doing, Respondents attempt to erroneously suggest the existence of purported factual "inaccuracies" in Freedman's petition. Indeed, Respondents do not even address the crux of Freedman's argument, namely, the issues of (i) whether the Federal Circuit's attempt to limit the doctrine of equivalents through its "foreseeability" doctrine is inconsistent with this Court's precedent, and (ii) whether a court can disregard the fact that the "function-way-result" test is met by an accused device, to find non-equivalence as a matter of law.

As shown below, however, Respondents' claims are not supported by the record. Accordingly, Respondents' brief in opposition fails to raise any legitimate reason for denial of Freedman's petition.

A. Respondents' Claim that "Petitioner's Questions are Not Presented in This Case" is Not Supported by the Record

For their first purported reason for denying Freedman's petition, Respondents erroneously state that "the questions posed by petitioner are not factually presented by this case" (Opp. 3). Specifically, Respondents claim that (a) certain factual issues relevant to the questions presented were "disputed" below, thereby suggesting that a genuine issue of material fact existed as to those issues, and (b) the questions presented by Freedman purportedly do not specify the "elements" at issue. However, Respondents' contentions are not at all supported by the record before this Court, as shown below.

1. The purported "disputes" identified by Respondents did not involve any genuine issues of material fact

First, Respondents claim that the issue of "whether the diagonal truss of the accused EZ Fold in fact performs the same function in the same way to achieve the same result as the claimed structure" was somehow "disputed" below (Opp. 3) – thereby suggesting that a genuine issue of material fact existed on this issue in the courts below. Respondents are wrong. Of course, if Respondents are correct, and there were disputed issues of material fact, then neither the district court nor the Federal Circuit could have ruled on the issue of infringement of the '389 patent under the doctrine of equivalents, as a matter of law. Indeed, if there were disputed issues of material fact, those issues would had to have been tried before the district court. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986) (holding that summary judgment can be granted only if no "reasonable jury could return a verdict for the nonmoving party").

Indeed, as the district court noted in granting summary judgment to Freedman on the issue of infringement,

Respondents' argument that the accused EZ Fold seat did not infringe the '389 patent under the doctrine of equivalents was based **solely** on purported differences between the **distribution of forces** in the accused EZ Fold seat and in the preferred embodiment of the '389 patent (App. 49-51). However, the district court found that Respondents' argument "focusing on the differences in the use of force on the seatbase . . . is marginally, if at all relevant," and held that Respondents failed to raise **any** genuine issue of material fact (App. 50). Thus, the district court found, there was no genuine issue of material fact that the "function-way-result" test was met by the "moveable end" in the accused EZ Fold seat, as a result of which the EZ Fold seat infringed the '389 patent under the doctrine of equivalents (App. 50-51). While Respondents may have "disputed" the issue of whether the "function-way-result" test was met in this case, the record clearly indicates that Respondents offered no evidence sufficient to create a **genuine** issue of **material** fact on that issue.

Moreover, the Federal Circuit did **not** hold the district court's finding that the "function-way-result" test had been met to have been erroneous. Indeed, the Federal Circuit never even addressed Respondents' argument that the "function-way-result" test was not met because of purported differences in force distribution between the accused EZ Fold seat and the preferred embodiment of the '389 patent, which Respondents had once again asserted on appeal. Instead, the Federal Circuit made no finding whatsoever that *any* genuine issue of material fact existed in this case with regard to the application of the "function-way-result" test. Accordingly, contrary to Respondents' suggestion, the record simply does not reflect the existence of any **genuine** issue of **material** fact relating to the application of the "function-way-result" test in this case.

Additionally, while Respondents claim that "[i]nterchangeability of the overall truss mechanisms was disputed" below (Opp. 3), the record clearly shows this statement to be false. To the contrary, both Freedman and

Respondents agreed below that the type of four-bar mechanisms utilized in the preferred embodiment of Freedman's '389 patent (referred to below as a "slider-crank" mechanism) and in the accused EZ Fold seat were, for all practical purposes, **interchangeable**. Indeed, the Federal Circuit acknowledged Respondents' claim that the two types of four-bar mechanisms were interchangeable:

[Respondents] argue that, at the time of filing for the '389 patent, the interchangeability of four bar mechanisms was foreseeable to one of skill in the art. [Respondents state] that this is significant because, while Freedman could have chosen to claim a fourth link mechanism (or even all types of four bar mechanisms), it chose to narrowly claim a slider-crank mechanism.

(App. 14). Further, the Federal Circuit expressly noted, in view of Freedman's awareness of this interchangeability, that its purported "decision" to limit its claims to slider-crank mechanisms was important (App. 25).

Clearly, both Freedman and Respondents were in agreement below that the two types of four-bar mechanisms employed in the accused EZ Fold seat and the preferred embodiment of the '389 patent were **interchangeable** with one another. The only **genuine** dispute on that issue was a legal one, not a factual one – namely, what effect that interchangeability had on the application of the doctrine of equivalents in this case. Thus, Respondents' claim of a purported factual "dispute" relating to the interchangeability of the two types of truss mechanisms is simply not supported by the record.

2. The "elements" at issue in the questions presented were clearly defined in Freedman's petition

Respondents also claim that Freedman's petition should be denied because the questions presented by Freedman purportedly "do not specify the 'elements'" at issue in this case (Opp. 3). Once again, Respondents'

position is not supported by the record. Clearly, the body of Freedman's petition establishes that the "elements" at issue are the "moveable end" of the '389 patent claims and the corresponding "moveable end" of the diagonal truss in Respondents' accused EZ Fold seat.¹ Respondents' suggestion that Freedman's petition should be denied because the questions presented do not "specify the elements" has no basis in law or fact, and therefore fails to raise a legitimate reason for denial of Freedman's petition.

Furthermore, Respondents' argument blatantly mischaracterizes the record below, by falsely stating that "Freedman presented *no* evidence whatsoever to establish that any specific element found in EZ Fold is equivalent to the slidably-mounted movable end element specifically recited in the patent claims" (Opp. 3). This statement is contradicted by **both** the district court **and** the Federal Circuit opinions, each of which noted the evidence presented by Freedman below demonstrating that the moveable end of the accused EZ Fold seat was equivalent to the slidably-mounted moveable end of the '389 patent claims.²

¹ Indeed, Freedman notes that Supreme Court Rule 14.1(a) states that the questions presented should be "expressed concisely in relation to the circumstances of the case, without unnecessary detail," and "should be short." Freedman complied with Rule 14.1(a) by listing the questions presented, without providing unnecessary factual detail in the questions themselves, which detail was clearly set forth in the body of Freedman's petition. Respondents' suggestion that the questions presented are somehow deficient because they failed to "specify" the "elements" at issue is wholly inconsistent with Rule 14.1(a).

² The district court summarized the evidence presented by Freedman regarding the equivalence between the "moveable ends" of the accused and patented seats as follows:

[T]he dispute arises as to whether the '389 Patent's support member and moveable end is equivalent to that found in the accused device. According to [Freedman], the accused device's support member has a moveable end that is associated with the seatbase in an equivalent manner as the '389 Patent. [Freedman] argues that the sole difference between the claims in the '389 Patent and the accused device is that the accused

(Continued on following page)

Contrary to Respondents' mischaracterization, the record clearly reflects that Freedman presented **substantial** evidence in the district court below, which evidence was noted by the Federal Circuit, that the moveable end of the accused EZ Fold seat was equivalent to the moveable end of the '389 patent claims.

B. Freedman Does Not Contend That the Federal Circuit's Use of the "All-Elements Rule" Conflicts With Supreme Court Precedent

While Respondents attempt to suggest that this case is about the "all-elements rule," Respondents' suggestion both ignores the substance of Freedman's petition and once again mischaracterizes the factual record. First, Freedman does not dispute that the "all-elements rule," as

device has a support member with a moveable end that is *rotatably mounted to a fourth link on the underside of the seatbase* whereas the '389 Patent's claims cover a support member with a moveable end that is *slidably and rotatably mounted within a runner track on the underside of the seatbase*.

(App. 47) (emphasis in original). Likewise, the Federal Circuit summarized the evidence presented by Freedman regarding the district court's proper application of the "function-way-result" test:

Freedman asserts that in both the accused product and the '389 patent, mounting the support member to the seatbase serves the function of attaching the moveable end of the support member to the seatbase while still permitting the seatbase to move between the horizontal and vertical positions. Second, Freedman asserts that the '389 patent and the accused product perform this function in the same way, by providing the movable end of the support member with both translational and rotational motion relative to the seatbase. Finally, Freedman asserts that both devices achieve the same result, namely, "the repositioning of the movable end, from a first position near the midpoint of the seatbase when the seatbase is stowed, to a position near the aisle end of the seatbase when the seatbase is deployed."

(App. 15).

set forth by this Court in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997),³ comprises a restriction on the doctrine of equivalents, which the Federal Circuit properly acknowledged. Freedman's position is that the Federal Circuit applied the all-elements rule improperly, by disregarding undisputed evidence that each element of Freedman's patent claims was present in the accused EZ Fold seat, either literally or through an equivalent, and then inappropriately applied its questionable "foreseeability" doctrine (first set forth by the Federal Circuit in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997)) to find non-equivalence of an interchangeable element, as a matter of law.

Further, Respondents once again erroneously suggest that Freedman somehow "fail[ed] to present evidence that EZ Fold had any element equivalent to the 'slidably mounted' moveable end expressly recited in all of the claims of the '389 patent" (Opp. 4). Again, this statement is simply *false*, in view of the substantial evidence of equivalence between those elements presented by Freedman below, as noted in both the district court and Federal Circuit opinions (see Sec. A.2, *supra*).

Finally, while Respondents argue that "the Federal Circuit did not use 'foreseeability' in any sense contrary to this Court's precedent," Respondents completely ignore the fundamental inconsistency between (i) the Federal Circuit's holding that the doctrine of equivalents is not

³ This Court summarized the "all-elements rule" as follows:

Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole. It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.

Warner-Jenkinson, 520 U.S. at 29.

applicable in this case, based on the fact that the **interchangeability** of Respondents' accused structure was "foreseeable" to the '389 patent inventors, and (ii) this Court's precedent, as reaffirmed in *Warner-Jenkinson*, that where the substitution of a claimed element with an accused element is known to persons skilled in the art to be **interchangeable**, the "foreseeability" that those elements can be interchanged for one another is an important factor that weighs in favor of, not against, a finding of equivalence. Respondents simply pretend that no such inconsistency exists, hoping that this Court will ignore it as well.

C. Freedman's Description of the "Moveable End" in the Accused EZ Fold Seat is Supported by the Record

Respondents erroneously argue that Freedman's description of the "moveable end" in the accused EZ Fold seat, as comprising the end of the EZ Fold diagonal truss which is attached to one end of the EZ Fold's "fourth link," with the other end of the "fourth link" being fixed to the bottom of the seatbase, was "not supported by the record in the district court and was properly rejected by the Federal Circuit" (Opp. 2). Respondents are wrong.

Notably, in the proceedings before the district court, Respondents did not even contest the issue of where the "moveable end" was located in the accused EZ Fold seat, but rather based their argument for non-equivalence on purported differences in the "distribution of forces" exerted on the seatbase and the support member in the accused and patented devices – an argument that was soundly rejected by the district court (App. 49-51). Indeed, the district court's opinion clearly noted Freedman's claim that the "moveable end" in the accused EZ Fold seat comprised the end of the EZ Fold diagonal truss that is "rotatably mounted" to the EZ Fold's "fourth link":

[Freedman] argues that . . . the accused device has a support member with a moveable end that

is *rotatably mounted to a fourth link* on the underside of the seatbase. (App. 47) (emphasis in original).

Furthermore, the Federal Circuit did **not** hold that the "moveable end" in the EZ Fold is the point at which the "fourth link" is fixed to the seatbase, as Respondents suggest. Rather, the Federal Circuit simply noted that the "moveable end" of the EZ Fold support member "is rotatably mounted to the seatbase," but does not **directly** contact the seatbase so as to "slide or otherwise move along the seatbase" (App. 7). This is entirely consistent with the district court's determination that the EZ Fold's "moveable end" is the end of the support member that is "rotatably mounted to a fourth link on the underside of the seatbase" (App. 47). The Federal Circuit's description of the moveable end of the support member in the accused EZ Fold seat, as being "rotatably mounted to the seatbase," is likewise consistent with the following description of the accused device, which the parties agreed below was accurate:

[Respondents'] device utilizes a brace [support member] connected to an intermediate [fourth] link. Due to this intermediate [fourth] link, the upper end of the brace does not contact with the seat base to support it. As the seat of the device pivots upward to the stowed position, the diagonal brace swings away from the bottom of the seat. (App. 36, n.5).

Moreover, Respondents concede that the "moveable end" of the EZ Fold's diagonal brace is provided "with translational and rotational motion" relative to the seatbase, by being "rotatably mounted to a fourth link on the underside of the seatbase" (App. 47), just as the "moveable end" of the '389 preferred embodiment's diagonal truss is provided "with translational **and** rotational motion" relative to the seatbase, by being "slidably mounted within a runner track" on the underside of the seatbase (App. II-6, '389 patent, col. 3, lines 41-56). Based on this fact, the

district court correctly found that the moveable end of the EZ Fold's support member performed the same function in the same way to achieve the same result as the slidably-mounted moveable end of the '389 patent claims (App. 49-51) – a holding which the Federal Circuit did not find to be erroneous. Thus, under this Court's precedent, the Federal Circuit should have affirmed the district court's holding – not reversed it, on the basis of the Federal Circuit's "foreseeability" doctrine, relative to the notion of interchangeability.

CONCLUSION

For the foregoing reasons, and for those set forth in Freedman's petition, the petition for writ of certiorari should be granted.

Respectfully submitted,

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